

ESTTA Tracking number: **ESTTA611572**

Filing date: **06/23/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206208
Party	Plaintiff Blue Cross and Blue Shield Association
Correspondence Address	Garner K. Weng Hanson Bridgett LLP 425 Market Street, 26th Floor San Francisco, CA 94105 UNITED STATES ttabfilings@hansonbridgett.com, gweng@hansonbridgett.com, soneill@hansonbridgett.com, cwalters@hansonbridgett.com
Submission	Motion to Compel Discovery
Filer's Name	Christopher S. Walters
Filer's e-mail	cwalters@hansonbridgett.com, ttabfilings@hansonbridgett.com, gweng@hansonbridgett.com, soneill@hansonbridgett.com
Signature	/Christopher S. Walters/
Date	06/23/2014
Attachments	Motion to Compel Discovery Responses.pdf(68895 bytes) Walters Decl iso Motion to Compel Discovery Responses.pdf(12316 bytes) Ex A-C to Walters Decl.pdf(3303828 bytes) Ex D-G to Walters Decl.pdf(2384063 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE: APPLICATION SERIAL NO. 85/363,867

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

v.

PALLADIAN HEALTH, LLC,

Applicant.

Opposition No. 91206208

**OPPOSER BLUE CROSS AND BLUE
SHIELD ASSOCIATION'S MOTION TO
COMPEL APPLICANT PALLADIAN
HEALTH, LLC TO PROVIDE FURTHER
RESPONSES TO INTERROGATORIES
(SET ONE) AND REQUESTS FOR
PRODUCTION (SET ONE)**

Pursuant to 37 C.F.R. § 2.120 and TMBP § 523, Opposer Blue Cross and Blue Shield Association hereby moves the Board for an order compelling Applicant Palladian Health, LLC to provide further responses to Opposer's Interrogatories (Set One) within 20 days, compelling Applicant to provide further responses and production of documents in response to Opposer's Requests for Production of Documents (Set One) within 20 days, and precluding Applicant from introducing as evidence responsive documents or facts that it does not provide following the Board's issuance of an order on this motion.

Blue Cross and Blue Shield Association also respectfully asks that the Board grant leave for it to conduct any needed follow-up discovery past the close of discovery after Blue Cross and Blue Shield Association receives further responses and document production from Applicant.

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. STATEMENT OF RELEVANT FACTS	1
III. ARGUMENT	2
A. BCBSA made a good faith effort to work with Applicant before filing this motion.	3
B. The Board should compel Applicant to produce documents responsive to BCBSA's Requests for Production (Set One) and issue an order precluding Applicant from introducing into evidence any documents or things Applicant has not produced within 20 days of the Board's order.	3
C. The Board should issue an order compelling Applicant to respond substantively and fully to BCBSA's interrogatories, and precluding Applicant from introducing as evidence any responsive information that it does not provide.....	10
IV. CONCLUSION.....	20

I. INTRODUCTION

Opposer Blue Cross and Blue Shield Association ("BCBSA") served first sets of written discovery on January 11, 2013, to which Applicant Palladian Health, LLC ("Applicant" or "Palladian") responded on or about April 18, 2013. Applicant's answers to BCBSA's interrogatories provided little substantive information and, in the case of many responses, objections only. Similarly, the documents Applicant produced did not contain any materials that were responsive to many categories requested by BCBSA, and Applicant provided only objections to many categories of requested documents.

BCBSA provided a detailed listing of its concerns with Applicant's written responses and document production, and authority for BCBSA's requests, in a letter on July 1, 2013. Applicant has not responded to BCBSA's letter, necessitating this motion to compel.

The discovery period is currently set to close on July 23, 2014.

II. STATEMENT OF RELEVANT FACTS

Opposer BCBSA filed its Notice of Opposition instituting these proceedings on July 23, 2012. As grounds for opposition, BCBSA alleged priority and likelihood of confusion under section 2(d), dilution under section 43(c), and fraud.¹ Applicant answered on or about August 31, 2012, denying BCBSA's claims and asserting 21 affirmative defenses. The parties then held their required discovery conference and served their respective initial disclosures on or about November 12, 2012.²

BCBSA served its Interrogatories (Set One) and Requests for Production (Set

¹ See Declaration of Christopher S. Walters ("Walters Decl."), ¶2.

² See *id.*

One) on January 11, 2013.³ After receiving extensions of time to respond, Applicant responded in writing and produced 133 pages of documents on or about April 18, 2013.⁴

BCBSA wrote to Applicant on July 1, 2013 and asked for Applicant's assistance in addressing several deficiencies BCBSA perceived with Applicant's written responses and the adequacy of its document production.⁵ Although the parties have exchanged several e-mails and spoken by phone over the ensuing several months to discuss potential amicable resolutions and case scheduling issues, Applicant has not responded to BCBSA's letter, provided supplemental or amended written responses, or produced any additional documents.⁶ BCBSA sent another follow-up communication to Applicant on June 20, 2014, before filing this motion, noting Applicant's lack of response to BCBSA's attempt to meet and confer.⁷ Applicant had not responded to that communication as of the time this motion was filed.⁸

III. ARGUMENT

Generally speaking, "the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition . . . proceedings."⁹ "If a party fails to make required initial disclosures . . . or fails to answer . . . any

³ See *id.* at ¶3, Exs. A and B.

⁴ See *id.* at ¶4, Exs. C and D.

⁵ See *id.* at ¶5, Ex. E.

⁶ See *id.* at ¶5.

⁷ See *id.* at ¶6, Ex. F.

⁸ See *id.* at ¶6.

⁹ 37 C.F.R. § 2.120(a)(1).

interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, . . . or an answer, or production and an opportunity to inspect and copy.”¹⁰

A. **BCBSA made a good faith effort to work with Applicant before filing this motion.**

BCBSA detailed its concerns regarding Applicant's responses to its Requests for Production (Set One) and Interrogatories (Set One) in a seven-page letter dated July 1, 2013.¹¹ Applicant has not responded to that letter, provided any supplemental written responses, or produced any additional documents.¹² And, Applicant did not reply to BCBSA's June 20, 2014 e-mail that noted Applicant's lack of response and stated that BCBSA would have to file this motion to compel in light of the case schedule.¹³

Despite BCBSA's efforts to resolve this dispute without the Board's involvement, Applicant's unresponsiveness to BCBSA's efforts makes this motion to compel necessary.

B. **The Board should compel Applicant to produce documents responsive to BCBSA's Requests for Production (Set One) and issue an order precluding Applicant from introducing into evidence any documents or things Applicant has not produced within 20 days of the Board's order.**

Requests for Production Nos. 2 and 3

BCBSA's request Nos. 2 and 3 ask Applicant for documents constituting,

¹⁰ 37 C.F.R. § 2.120(e)(1).

¹¹ See Walters Decl. ¶5, Ex. E.

¹² See *id.* at ¶5.

¹³ See *id.* at ¶6, Ex. F.

evidencing, or relating to communications between Applicant and HealthNow New York, Inc. – a trademark licensee of BCBSA – relating to:

2. services described in the Application or Applicant's Specimen of Use; and
3. FITBLUE, Applicant's Services under Applicant's Mark, or the website at fitblue.com.

Applicant objected that these requests are "vague, ambiguous, overbroad and unduly burdensome," and that the documents sought are irrelevant. Applicant provided no support for its assertion that the requests are vague or ambiguous, and they are not overbroad or unduly burdensome; indeed, they ask Applicant for communications with a single entity related to the mark and services at issue. Further, the requests are relevant because BCBSA alleges in part that its rights in the FITBLUE mark arise through use by its licensee, HealthNow New York, Inc.¹⁴ Applicant's relationship with HealthNow is therefore relevant because rights in the FITBLUE mark may flow to BCBSA by virtue of HealthNow's use of the mark. Indeed, the documents produced by Applicant to date only show use of the FITBLUE mark in conjunction with HealthNow.

Additionally, Applicant's communications with BCBSA's licensee are likely to shed light on Applicant's claim that it "has priority and came up with the mark," as pled in its answer.

Applicant has produced only one communication between itself and HealthNow New York. Accordingly, BCBSA asks for an order compelling Applicant to produce all such communications and precluding Applicant from introducing as evidence any communications with HealthNow New York that it does not produce within 20 days of

¹⁴ See Fed. R. Civ. P., Rule 26(b)(1) (parties are entitled to seek discovery of any matter that is relevant to any party's claims or defenses).

the Board's order.

Requests for Production No. 12 and 16

BCBSA's request No. 12 asks for "All 'Documents reflecting Applicant's creation and first use of its mark,' as referenced in Applicant's Initial Disclosures in this proceeding." Request No. 16 asks for "All documents and things constituting or relating to Applicant's creation, consideration, design, development, selection, or adoption of Applicant's Mark."

Applicant objected that the requests are "overbroad and unduly burdensome," and identified eight responsive documents. The produced documents do not appear to reflect Applicant's creation, consideration, design, development, selection, adoption or first use of the FITBLUE mark at issue.

Applicant's application claims a first use in commerce date of January 1, 2007, and Applicant's answer alleges that it "came up with the mark" and "was the first to use the mark in commerce." Accordingly, the requests are directly relevant to Applicant's defenses – they are not overbroad or unduly burdensome. In addition, the Board specifically states that these materials are discoverable.¹⁵

BCBSA asks that the Board overrule Applicant's objections, compel Applicant to produce all documents responsive to requests Nos. 12 and 16 within 20 days of the Board's order, and order that Applicant be precluded from introducing as evidence any responsive documents that it does not produce within that time.

Request for Production Nos. 14 and 15

BCBSA's requests Nos. 14 and 15 seek:

¹⁵ TBMP § 414(4) and (5).

14. all documents “reflecting Opposer’s services and goods,” and
15. all documents “reflecting third party use and registration of marks containing the word BLUE.”

Applicant stated in its initial disclosures that these documents were “in the possession, custody, or control of Applicant and may be used to support its claims and defenses.”¹⁶ In response to BCBSA’s request No. 14, Applicant objects by alleging the request is “overbroad and unduly burdensome,” and that the materials sought “are in the possession of the Opposer.” These objections are inconsistent with Applicant’s initial disclosures. BCBSA is entitled to seek discovery of any matter that is relevant to any party’s claims or defenses,¹⁷ and it is entitled to documents listed in Applicant’s initial disclosures.

In response to No. 15, Applicant objects that the request is “vague, ambiguous, overbroad and unduly burdensome,” “the materials are publicly available,” and “seeks materials protected by the attorney work product doctrine.” None of these objections warrant withholding the requested materials. The request asks for documents Applicant identified in its initial disclosures. This is not vague or burdensome. The fact that materials are publicly available is not proper grounds for withholding production.¹⁸ And, Applicant’s asserted privileges are inapplicable if Applicant will use them to support its defenses. Further, the Board has noted that these materials are discoverable.¹⁹

Accordingly, BCBSA requests an order compelling Applicant to produce

¹⁶ See Walters Decl., ¶7, Ex. G.

¹⁷ Fed. R. Civ. P., Rule 26(b)(1).

¹⁸ Fed. R. Civ. P., Rule 34(a)(1) (responding party must produce documents in its possession, custody, or control).

¹⁹ TBMP § 414(9).

documents responsive to BCBSA's requests Nos. 14 and 15 within 20 days of the Board's order, and precluding Applicant from introducing as evidence responsive documents that Applicant does not produce within that time.

Request for Production No. 18

BCBSA's request for production No. 18 asks for "All documents and things constituting or relating to Applicant's conducting any searches or other due diligence regarding Applicant's Mark, including but without limitation all documents and things relating to the availability of Applicant's Mark for use or registration." Applicant declined to produce any documents on the basis of attorney-client privilege and the attorney work product doctrine. The contents of search reports, however, are discoverable.²⁰

Accordingly, BCBSA requests an order compelling Applicant to produce its search reports related to the mark at issue within 20 days of the Board's order.

Requests for Production Nos. 21 and 23

BCBSA requested the following from Applicant:

21. Representative samples of all instances, manners, and ways in which Applicant's Mark has been used in connection with offering or selling goods or services by Applicant;
23. All documents and things constituting or relating to the dates of first use and first use in commerce by Applicant of Applicant's Mark;

Applicant asserted the same boilerplate objection to all of these requests that "it is vague, ambiguous, overbroad and unduly burdensome." Applicant has provided no explanation for any of the requests being vague or ambiguous, and Applicant does not

²⁰ TBMP § 414(6).

explain how any request is unduly burdensome.²¹

Substantively, Applicant responded to all of these requests by simply referring BCBSA to its responses to request Nos. 12 or 13, or both. Applicant has an obligation to respond to each of BCBSA's requests, and responding with reference to other responses or discovery materials is insufficient.²²

These requested documents are central to the current dispute. They request samples of all instances of Applicant's use of the FITBLUE mark at issue and documents evidencing a first use date in commerce. Applicant has produced only a few specimens on newsletters from 2009 and 2010 – years after Applicant's claimed first use date of January 1, 2007. BCBSA is entitled to know how the mark at issue has been used, and to see evidence of a claimed first use in commerce date.

In light of the foregoing, BCBSA requests an order overruling Applicant's objections, compelling Applicant to respond separately to these requests for production, compelling Applicant to produce documents and things responsive to these requests within 20 days of the Board's order, and precluding Applicant from introducing as evidence responsive documents that Applicant does not produce within that time.

Requests for Production Nos. 22, 24, 26, 28, 32-35, and 45

BCBSA requested the following from Applicant:

22. Documents or things sufficient to show all types of goods or services offered by Applicant under Applicant's Mark;

²¹ See *Sallah v. Worldwide Clearing LLC*, 855 F. Supp. 2d 1364, 1376 (S.D. Fla. 2012) (party claiming undue burden must support the objection with specific information demonstrating how the request is overly burdensome).

²² See Fed. R. Civ. P., Rule 34(b)(2)(B) (party answering discovery must respond to each item or category requested).

- 24. All documents and things constituting or relating to correspondence with any advertising or sales agent related to Applicant's Mark;
- 26. All documents and things constituting or relating to Applicant's past, present, or future marketing plans involving Applicant's Mark.
- 28. All documents and things evidencing or relating to the recipients of the newsletter or other publication shown in Applicant's Specimen of Use submitted with the Application.
- 32. All documents and things evidencing or relating to the geographic areas where Applicant offers or sells Applicant's Services under Applicant's Mark.
- 33. All documents and things evidencing or relating to the channels of trade in which Applicant offers or sells Applicant's Services under Applicant's Mark.
- 34. All documents and things evidencing or relating to the class of customers for Applicant's Services offered under Applicant's Mark.
- 35. All documents and things evidencing or relating to the identity of Applicant's potential customers who receive or see Applicant's advertising or other promotion using Applicant's Mark.
- 45. Copies of all marketing pitch packages to any entities relating to Applicant's Mark, including the goods and services offered in connection with Applicant's Mark.

Applicant asserted the same boilerplate objection to all of these requests that "it is vague, ambiguous, overbroad and unduly burdensome." Applicant has provided no explanation for any of the requests being vague or ambiguous, and Applicant does not explain how any request is unduly burdensome.²³ In addition, Application objected that No. 35 asks for trade secrets and that No. 45 seeks irrelevant information. But, Applicant does not explain how this information – the identity of Applicant's potential customers – is so sensitive that it cannot be disclosed even under the Board's standard

²³ See *Sallah v. Worldwide Clearing LLC*, 855 F. Supp. 2d 1364, 1376 (S.D. Fla. 2012) (party claiming undue burden must support the objection with specific information demonstrating how the request is overly burdensome).

protective order. And, the marketing pitch packages requested in No. 45 are likely to discuss the goods and services offered under the disputed mark and shed light on Applicant's plans for expansion, both of which are relevant and discoverable subjects.²⁴ Accordingly, BCBSA asks that Applicant's objections be overruled.

Substantively, Applicant responded to all of these requests by simply referring BCBSA to its responses to request Nos. 12 or 13, or both. Applicant has an obligation to respond to each of BCBSA's requests, and responding with reference to other responses or discovery materials is insufficient.²⁵

In light of the foregoing, BCBSA requests an order overruling Applicant's objections, compelling Applicant to respond separately to these requests for production, compelling Applicant to produce documents and things responsive to these requests within 20 days of the Board's order, and precluding Applicant from introducing as evidence responsive documents that Applicant does not produce within that time.

- C. **The Board should issue an order compelling Applicant to respond substantively and fully to BCBSA's interrogatories, and precluding Applicant from introducing as evidence any responsive information that it does not provide.**

Interrogatory No. 11

Interrogatory No. 11 asks for the names and contact information of each person involved with selecting Applicant's Mark for use in connection with the services stated in the Application.

In response, Applicant provided the name of one person, Mark Zygaj, and stated,

²⁴ See TBMP § 414(9).

²⁵ See Fed. R. Civ. P., Rule 34(b)(2)(B) (party answering discovery must respond to each item or category requested).

“Applicant does not know the name of every person who took part in selecting FITBLUE for use with Applicant’s services.” Applicant’s response suggests that multiple people were involved in selecting Applicant’s Mark, but only identifies one person. BCBSA asked Applicant to supplement its response either by identifying other people involved in selecting Applicant’s mark or clarifying whether Mr. Zygaj was the only person responsible for the decision. Applicant has not provided any supplementation.

This interrogatory seeks information that is relevant for determining the identities of people with information about the selection of Applicant’s Mark and people whose depositions may need to be taken in anticipation of trial.²⁶ Accordingly, BCBSA respectfully requests that the Board compel Applicant to supplement its response to Interrogatory No. 11.

Interrogatory No. 12

Interrogatory No. 12 asks that Applicant provide all factual and legal bases for Applicant’s contention that no likelihood of confusion exists between “Applicant’s Mark vis a vis Opposer Blue Cross and Blue Shield Associations’ FITBLUE Marks.”

In response, Applicant merely refers BCBSA to Applicant’s Answer and Affirmative Defenses. This sparse response is inadequate, given the importance and relevance of the inquiry.²⁷ Applicant’s Answer consists almost entirely of denials while

²⁶ See *Goodyear Tire & Rubber Co. v. Tyrco Ind.*, 186 U.S.P.Q. 107 (TTAB 1975) (granting a motion to compel a response to an interrogatory seeking the names of people involved in creating a mark because the interrogatory would allow a party to find the names of “knowledgeable people whose depositions might profitably be taken in preparation for trial”).

²⁷ See TBMP § 414; see *also* *Gould Inc. v. Sanyo Electric Co.*, 179 U.S.P.Q. 313, 314 (TTAB 1973) (determining that the question of whether a party believes marks to be confusingly similar is relevant).

its Affirmative Defenses are a collection of unsubstantiated statements, many of which are unrelated to the issue of likelihood of confusion.

Applicant has an obligation to answer each interrogatory “fully,”²⁸ and BCBSA respectfully requests that the Board order Applicant to supplement its response to Interrogatory No. 12 by providing factual and legal support for its contention that there is no likelihood of confusion within 20 days of the Board's order, and preclude Applicant from introducing as evidence responsive information that Applicant does not provide within that time.

Interrogatory No. 21

This interrogatory seeks all legal and factual bases for Applicant's Affirmative Defense No. 9 asserting that the parties' “services are not marketed through the same channels of trade.”

In response, Applicant states that Applicant's services are only marketed in New York state. Channels of trade, however, encompass more than just the geographic area in which the services are offered for sale.²⁹

BCBSA respectfully requests that the Board order Applicant to supplement its response to this interrogatory to include the channels of trade through which Applicant's services are sold, and not just the geographic scope of their sale, within 20 days of the Board's order, and preclude Applicant from introducing as evidence responsive information that Applicant does not provide within that time.

²⁸ TBMP § 405.04(b); Fed. R. Civ. P. 33(b)(3).

²⁹ See, e.g., *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1370 (Fed. Cir. 2012) (noting that channels of trade include the types of outlets through which goods are sold).

Interrogatory No. 22

Interrogatory No. 22 seeks a detailed description of the channels of trade utilized by Applicant.³⁰

In response, Applicant objects by alleging that the interrogatory is “vague, ambiguous, overbroad, and unduly burdensome” and that it is “premature and asks for a legal conclusion.” The objections are unwarranted. First, Applicant does not offer any explanation for why the interrogatory is vague or ambiguous. Furthermore, the interrogatory is not overbroad or unduly burdensome; indeed, it asks for specific information related to Applicant’s use of its mark. In addition, the channels of trade associated with a mark represent a factual question integral to the likelihood of confusion analysis.³¹ Because the information sought is factual in nature, the interrogatory does not call for a legal confusion. Finally, the interrogatory is not premature. The discovery period is the appropriate time to inquire into relevant facts such as this.

In light of the foregoing, BCBSA respectfully requests that the Board overrule Applicant's objections and order Applicant to respond to Interrogatory No. 22 by fully answering the question posed within 20 days of the Board's order, and preclude

³⁰ BCBSA acknowledges that its reference in Interrogatory No. 22 to Applicant’s Affirmative Defense No. 2 was inadvertent and that it instead intended to refer to Affirmative Defense No. 9, and incorporate the meaning Applicant assigned to “channels of trade.” In case Applicant’s response stemmed from its confusion about the Affirmative Defense referenced, BCBSA clarified this confusion in the July 1, 2013 letter sent to Applicant.

³¹ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (“In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered: [...] (3) The similarity or dissimilarity of established, likely-to-continue trade channels.”).

Applicant from introducing as evidence responsive information that Applicant does not provide within that time.

Interrogatory Nos. 19-20, 24-25, 27, and 29

Interrogatory Nos. 19-20, 24-25, 27, and 29 each seek the factual and legal bases underlying certain of Applicant's affirmative defenses enumerated in its Answer, namely:

19. that "'FIT' is registered in trademarks for health related goods and services not owned by Opposer";
20. that "'FIT' is used in commerce by third parties as part of trademark for health related goods and services";
24. that "Applicant's mark and Opposer's marks are not likely to cause confusion, mistake or deception to purchasers as to the source of Opposer's goods or services";
25. that "Applicant's mark and Opposer's marks are not likely to disparage or falsely suggest a trade connection between Opposer and Applicant";
27. that "Applicant was the first to use the mark in commerce"; and
29. that "Applicant's mark is not likely to dilute the distinctive quality of any of Opposer's marks".

In response to each interrogatory, Applicant declines to provide any additional factual or legal detail. Instead, Applicant asserts that each of the statements "speaks for itself." This is insufficient to satisfy Applicant's obligation to respond "fully" to each interrogatory.³² Applicant's Affirmative Defenses are broad factual statements that imply supporting facts. For example, if Applicant states that "'FIT' is registered in trademarks for health related goods and services not owned by Opposer" and "'FIT' is used in

³² Fed. R. Civ. P 33(b)(3) ("Each interrogatory must, to the extent it is not objected to, be answered separately and fully in writing under oath."); TBMP § 405.04(b)

commerce by third parties as part of trademarks for health related goods and services” (see responses to Interrogatories 19-20), what corresponding marks exist of which Applicant is aware?³³ If “Applicant was the first to use the mark in commerce” (see response to Interrogatory 27), what underlying factual details exist to support Applicant’s allegation? These statements, and the others referenced above, do not simply “speak for themselves.”

Given Applicant’s responses and the importance of the information sought by each interrogatory, BCBSA respectfully requests that the Board order Applicant to supplement its responses to Interrogatory Nos. 19-20, 24-25, 27, and 29 by providing the requested factual and legal bases for each statement concerned within 20 days of the Board’s order, and preclude Applicant from introducing as evidence responsive information that Applicant does not provide within that time.

Interrogatory Nos. 31-34

Interrogatory Nos. 31-34 seek the factual and legal bases for the following Affirmative Defenses alleged by Applicant:

31. that “The Notice of Opposition is barred by reason of acts, omissions, representations and courses of conduct by Opposer which Applicant was led to rely to its detriment”;
32. that “Opposer’s inequitable conduct constitutes unclean hands”;
33. that “Opposer did not timely commence this action and it is therefore barred”; and

³³ *American Soc’y of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 U.S.P.Q. 531 (T.T.A.B. 1979) (concluding, “the Board has now come to believe that a party should be required to furnish information concerning the use or registration by third parties of the same or similar marks for the same or closely related goods or services as his involved mark and goods or services”).

34. that “Defects in the Notice of Opposition and in service of the Notice of Opposition are a bar to this action.”

In response to each, Applicant objects that the requests are “vague, ambiguous, overbroad and unduly burdensome.” These objections are unwarranted. Applicant must object with specificity and not merely assert boilerplate, yet Applicant does not give any support for these objections.³⁴ Moreover, BCBSA’s requests are clear and precise requests for the factual and legal bases supporting Applicant’s own Affirmative Defenses.

Applicant further objects by stating that the interrogatories are “premature” and call “for a legal conclusion.” These requests are not premature. Discovery is the appropriate time to investigate the facts underlying parties’ statements in their pleadings. Further, the requests on their face seek factual and legal bases, and not conclusions.

In light of the foregoing, BCBSA respectfully requests that the Board overrule Applicant’s objections and order Applicant to answer Interrogatory Nos. 31-34 by providing all factual and legal conclusions for the stated contentions within 20 days of the Board’s order, and preclude Applicant from introducing as evidence responsive information that Applicant does not provide within that time.

Interrogatory No. 35

Interrogatory No. 35 asks whether Applicant conducted any trademark search before proceeding with Applicant’s Mark.

Substantively, Applicant declines to respond and instead objects on the basis of

³⁴ TBMP § 405.04(b); Fed. R. Civ. P. 33(b)(4).

attorney-client privilege and work product doctrine, among other objections. Whether Applicant conducted a search report and, if so, the contents of such report, are discoverable.³⁵ Accordingly, BCBSA respectfully requests that the Board compel Applicant to respond substantively to Interrogatory No. 35 within 20 days of the Board's order.

Interrogatory No. 37

Interrogatory No. 37 asks for the date on which Applicant first became aware of any of BCBSA's Blue Marks.

Applicant objects in part on the grounds that it has not been given a list specifying the "Blue Marks." BCBSA, however, defined the Blue Marks in its Notice of Opposition and again in BCBSA's Interrogatories to Applicant (Set One). This definition of the Blue Marks is sufficient to allow Applicant to respond. Nevertheless, BCBSA also produced a partial list of BCBSA's Blue Marks in the United States at Bates Nos. BCBSA000708-000732 and identified those documents in its July 1, 2013 letter to Applicant. Despite this clarification, Applicant has not amended or supplemented its response.

In light of the above, BCBSA respectfully requests that the Board overrule Applicant's objection and order Applicant to supplement its response to Interrogatory No. 37 with the requested date(s) within 20 days of the Board's order.

Interrogatory No. 42

Interrogatory No. 42 asks Applicant to "[i]dentify all entities Applicant pitched to

³⁵ TBMP § 414(6) ("Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived).").

perform services under Applicant's Mark."

In response, Applicant refuses to respond substantively and objects by alleging that the interrogatory is "vague, ambiguous, overbroad and unduly burdensome." These objections are unwarranted. Applicant did not offer any support for its contention that the interrogatory is "vague" or "ambiguous." Moreover, BCBSA clarified the request in its July 1, 2013 letter with the following explanation: "BCBSA seeks the names of entities (e.g., businesses or organizations) to which Applicant offered or sought to offer to perform any service (e.g., administration of health benefit plans concerning fitness center memberships, promoting enrollment in fitness centers to health benefit plan members, etc.)."³⁶

In light of the foregoing, BCBSA respectfully requests that the Board overrule Applicant's objections and order Applicant to respond substantively to this interrogatory within 20 days of the Board's order.

Interrogatory Nos. 44-46

Interrogatory Nos. 44-46 ask Applicant to identify whether Applicant pitched to perform services under Applicant's Mark to some of BCBSA's licensees, namely

- 44. Blue Cross and Blue Shield of Florida;
- 45. Blue Cross and Blue Shield of North Carolina; and
- 46. Blue Cross and Blue Shield of South Carolina.

If Applicant did pitch services, the interrogatories also seek the date(s) of such

³⁶ Applicant's refusal to respond is especially peculiar given that Applicant was willing to answer similar questions in Interrogatory Nos. 43-46, which ask whether Applicant pitched services to Blue Cross and Blue Shield of Arizona, Blue Cross and Blue Shield of Florida, Blue Cross and Blue Shield of North Carolina, and Blue Cross and Blue Shield of South Carolina.

pitches, the names of individuals pitched to, and all materials provided to each licensee.

In response, Applicant states that it pitched its services to all three licensees, but does not provide the requested names of the people to which it presented. Nor does Applicant identify the materials provided to those entities in connection with its marketing efforts.

BCBSA respectfully requests that the Board order Applicant to supplement its responses to Interrogatory Nos. 44-46 by identifying the requested individuals' names and materials provided along with the pitch within 20 days of the Board's order.

Interrogatory No. 47

Interrogatory No. 47 asks Applicant to “[d]escribe in detail the meaning of Applicant’s Mark, particularly the ‘BLUE’ portion of Applicant’s Mark.”

Applicant responds by stating that FITBLUE is “related to its services being provided under the mark” and lists the services identified in its trademark application. Applicant does not offer any explanation for why the BLUE portion of the mark is in any way related to the “Administration of health benefit plans concerning fitness center memberships” or “promoting enrollment in fitness centers to health benefit plan members.” This information is clearly relevant and, indeed, is referenced in Applicant’s document production.³⁷

In light of the above, BCBSA respectfully requests that the Board order Applicant to supplement its response to Interrogatory No. 47 by providing the requested detailed description within 20 days of the Board's order, and preclude Applicant from introducing

³⁷ TBMP § 414(4)(“Information concerning a party’s selection and adoption of its involved mark is generally discoverable (particularly of a defendant.)”).

as evidence responsive information that Applicant does not provide within that time.

IV. CONCLUSION

In light of all the foregoing, BCBSA respectfully asks for an order compelling Applicant Palladian Health, LLC to provide further responses to Opposer's Interrogatories (Set One) within 20 days, compelling Applicant to provide further responses and production of documents in response to Opposer's Requests for Production of Documents (Set One) within 20 days, and precluding Applicant from introducing as evidence responsive documents or facts that it does not provide following the Board's issuance of an order on this motion.

Finally, BCBSA also respectfully asks that the Board grant leave for it to conduct any needed follow-up discovery past the close of discovery after Blue Cross and Blue Shield Association receives further responses and document production from Applicant.

Respectfully submitted,

BLUE CROSS AND BLUE SHIELD
ASSOCIATION

By /s/ Christopher S. Walters
Susan G. O'Neill, Esq.
Garner K. Weng, Esq.
Christopher S. Walters, Esq.
Attorneys for Opposer
Blue Cross and Blue Shield Association

Hanson Bridgett LLP
425 Market Street, 26th Floor
San Francisco, CA 94105
Tel.: (415) 777-3200
E-mail: soneill@hansonbridgett.com
E-mail: gweng@hansonbridgett.com
E-mail: cwalters@hansonbridgett.com

Date: June 23, 2014

CERTIFICATE OF SERVICE

I, Laura Prongos, hereby certify that a true and complete copy of the foregoing **OPPOSER BLUE CROSS AND BLUE SHIELD ASSOCIATION'S MOTION TO COMPEL APPLICANT PALLADIAN HEALTH, LLC TO PROVIDE FURTHER RESPONSES TO INTERROGATORIES (SET ONE) AND REQUESTS FOR PRODUCTION (SET ONE)** was served on the parties listed below by mailing said copies on June 23, 2014 via U.S. First Class Mail, postage pre-paid to:

Marybeth Priore Colucci & Gallaher, P.C. 2000 Liberty Building 424 Main Street Buffalo, NY 14202	<i>Attorney for Applicant</i> Palladian Health, LLC
--	---

Dated: June 23, 2014

/s/ Laura Prongos
Laura Prongos

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE: APPLICATION SERIAL NO. 85/363,867

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

v.

PALLADIAN HEALTH, LLC,

Applicant.

Opposition No. 91206208

**DECLARATION OF CHRISTOPHER S.
WALTERS IN SUPPORT OF OPPOSER
BLUE CROSS AND BLUE SHIELD
ASSOCIATION'S MOTION TO COMPEL
APPLICANT PALLADIAN HEALTH, LLC
TO PROVIDE FURTHER RESPONSES
TO INTERROGATORIES (SET ONE)
AND REQUESTS FOR PRODUCTION
(SET ONE)**

I, Christopher S. Walters, declare:

1. I am one of the attorneys of record for Opposer Blue Cross and Blue Shield Association in the above-referenced action, and I make this Declaration in support of Opposer Blue Cross and Blue Shield Association's Motion to Compel Further Responses from Applicant Palladian Health, LLC's to Opposer's Interrogatories (Set One) and Requests for Production of Documents (Set One). I have personal knowledge of the facts stated in this declaration and, if called upon, could and would competently testify to them. All of the matters stated here are known to me personally, unless stated on information and belief; and with regard to those statements, I am informed and reasonably believe them to be true.

2. Blue Cross and Blue Shield Association filed its Notice of Opposition alleging priority and likelihood of confusion under section 2(d), dilution under section

43(c), and fraud on or about July 23, 2012. The parties held the required discovery conference by phone, and later served their respective initial disclosures.

3. True and correct copies of BCBSA's Interrogatories (Set One) and Requests for Production of Documents (Set One), including proofs of service, are attached hereto as Exhibits A and B, respectively.

4. True and correct copies of Applicant's written responses to BCBSA's Interrogatories (Set One) and Requests for Production of Documents (Set One) are attached hereto as Exhibits C and D, respectively. Applicant also produced 133 pages of documents the same day it provided written responses.

5. A true and correct copy of BCBSA's July 1, 2013 letter to Applicant is attached hereto as Exhibit E. The parties have exchanged several e-mails and spoken by phone over the ensuing several months to discuss potential amicable resolutions and case scheduling issues, but Applicant has not responded to BCBSA's letter, provided supplemental or amended written responses, or produced any additional documents.

6. A true and correct copy of my June 20, 2014 e-mail to Applicant's counsel of record is attached hereto as Exhibit F. Applicant had not responded to that communication as of the time this motion to compel was filed.

7. A true and correct copy of Applicant's initial disclosures is attached hereto as Exhibit G.

The rest of this page left blank intentionally.

I declare under penalty of perjury under the laws of the United States of America
that the foregoing is true and correct.

Executed this 23rd day of June 2014, at San Francisco, California.

/s/ Christopher S. Walters

Christopher S. Walters

CERTIFICATE OF SERVICE

I, Laura Prongos, hereby certify that a true and complete copy of the foregoing **DECLARATION OF CHRISTOPHER S. WALTERS IN SUPPORT OF OPPOSER BLUE CROSS AND BLUE SHIELD ASSOCIATION'S MOTION TO COMPEL APPLICANT PALLADIAN HEALTH, LLC TO PROVIDE FURTHER RESPONSES TO INTERROGATORIES (SET ONE) AND REQUESTS FOR PRODUCTION (SET ONE)** was served on the parties listed below by mailing said copies on June 23, 2014 via U.S. First Class Mail, postage pre-paid to:

Marybeth Priore Colucci & Gallaher, P.C. 2000 Liberty Building 424 Main Street Buffalo, NY 14202	<i>Attorney for Applicant</i> Palladian Health, LLC
--	---

Dated: June 23, 2014

/s/ Laura Prongos

Laura Prongos

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN RE: APPLICATION SERIAL NO. 85/363,867

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

PALLADIAN HEALTH, LLC,

Applicant.

Opposition No. 91206208

**OPPOSER BLUE CROSS AND BLUE
SHIELD ASSOCIATION'S
INTERROGATORIES TO APPLICANT
PALLADIAN HEALTH, LLC (SET ONE)**

PROPOUNDING PARTY: BLUE CROSS AND BLUE SHIELD ASSOCIATION

RESPONDING PARTY: PALLADIAN HEALTH, LLC

SET NO.: One

Pursuant to TBMP §§ 401 et seq., 37 C.F.R. § 2.120(a) & (d), and FRCP 33, Opposer BLUE CROSS AND BLUE SHIELD ASSOCIATION, by and through its undersigned counsel, requests that Applicant PALLADIAN HEALTH, LLC answer the following interrogatories separately and fully, within 30 days from service of this request (as may be properly adjusted based on the method of service under applicable rules).

DEFINITIONS

The following definitions and manners of interpretation apply to each instruction and interrogatory set forth here as if incorporated within each request.

1. The terms "relates to," "relate to," and "relating to" mean concerning, evidencing, showing, supporting, summarizing, describing, about, connected with, commenting on, addressing the subject matter of, alluding to, bearing on, consisting of, constituting, being, and referring to in any way.

2. The terms "Opposer," "Blue Cross and Blue Shield Association," "BCBSA," and "Association" refer to Opposer Blue Cross and Blue Shield Association.

3. The terms "you," "your," "Applicant," and "Palladian Health" refer to Applicant Palladian Health, LLC, including without limitation any predecessor in interest such as Prism Health Networks and its or their officers, directors, employees, attorneys, or other agents acting in the course and scope of their employment or roles with or otherwise acting on behalf of Palladian Health, LLC.

4. The term "Application" means the application for federal registration that is the subject of this proceeding, namely, Application Serial No. 85/363,867.

5. The term "Applicant's Mark" means the mark that is the subject of the Application.

6. The term "Applicant's Services" means any and all services provided under Applicant's Mark, including without limitation those listed in the Application.

7. The term "Applicant's Specimen of Use" means any and all specimens of use submitted to the U.S. Patent & Trademark Office by Applicant in connection with the Application.

8. The term "Blue Marks" means any mark used or that is the subject of a registration by Opposer Blue Cross and Blue Shield Association (including without limitation through its member plans and licensees) that consists of or includes the term BLUE or a blue-colored design element.

9. The terms "FITBLUE Mark" and "FITBLUE Marks" mean any mark or marks consisting of or including the term "FITBLUE" or "FIT BLUE".

10. The term "BlueCross BlueShield of Western New York" refers to BlueCross BlueShield of Western New York, a division of HealthNow New York, Inc.

11. The term "BlueShield of Northeastern New York" refers to BlueShield of Northeastern New York, a division of HealthNow New York, Inc.

12. The terms "HealthNow" and "HealthNow New York" refer to HealthNow New York, Inc.

INSTRUCTIONS

The following instructions apply to each interrogatory set forth here as if incorporated within each interrogatory.

1. Set forth each interrogatory before each response.
2. Provide a separate response to each interrogatory, and when an interrogatory has subdivisions, to each subdivision.
3. Respond to each interrogatory based on all information and documents in your knowledge or control, as well as that information reasonably available to you, including that in the knowledge or control of your officers, directors, attorneys, agents, representatives, employees, or other persons acting on your behalf.
4. In the event you are not able to provide a complete answer to a particular interrogatory, answer to the extent possible and state the reasons for the inability to provide a complete answer.
5. If you object to a portion of an interrogatory, provide the information requested by the portion of the interrogatory to which you do not object and/or to the extent to which you do not object to the interrogatory.
6. For any response in which information is withheld on the grounds of privilege, or other grounds, please provide a written response with the following information: (a) a description of the information sufficiently particular to identify it for purposes of a Board order; (b) the nature of the protection claimed; and (c) the factual basis of the protection claimed sufficient to permit the Board to adjudicate the validity of the claim.
7. Each interrogatory will be deemed to be continuing so as to require prompt supplementation of responses as provided by the Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Manual of Procedure.

INTERROGATORIES

INTERROGATORY NO. 1:

Please describe in detail all goods and services offered by Applicant under Applicant's Mark.

INTERROGATORY NO. 2:

Please describe in detail the relationship between BlueCross BlueShield of Western New York's and BlueShield of Northeastern New York's FITBLUE program described on www.fitblue.com and Applicant's Services under Applicant's Mark.

INTERROGATORY NO. 3:

State the dates of Applicant's relationship with HealthNow, including beginning date, date of execution of any contracts and termination of relationship dates.

INTERROGATORY NO. 4:

Please describe in detail to whom the publication shown in Applicant's Specimen of Use is disseminated.

INTERROGATORY NO. 5:

Please describe in detail who are "FitBlue members" (as that term is used in Applicant's Specimen of Use and on the website at www.fitblue.com).

INTERROGATORY NO. 6:

Please describe in detail all uses of Applicant's Mark by Applicant that have not in any way involved BlueCross BlueShield of Western New York or BlueShield of Northeastern New York.

INTERROGATORY NO. 7:

Please describe in detail all geographic areas in which Applicant provides Applicant's Services under Applicant's Mark.

INTERROGATORY NO. 8:

For each geographic area identified in your answer to the immediately preceding interrogatory, please state the date of Applicant's first use of Applicant's Mark in commerce.

INTERROGATORY NO. 9:

Please identify each person involved in the creation of Applicant's Mark, including by stating each such person's full name, title, current or last-known address, current or last-known telephone number, current or last known e-mail address, current or last-known employer, and employer at the time he or she was involved in the creation or design of Applicant's Mark.

INTERROGATORY NO. 10:

For each person identified in the response to the immediately preceding interrogatory, please describe in detail that person's role, responsibilities, and contributions to or regarding Applicant's Mark.

INTERROGATORY NO. 11:

Please identify each person who was responsible for selecting Applicant's Mark for use with Applicant's Services, including by stating each such person's full name, title, current or last-known address, current or last-known telephone number, current or last known e-mail address, and current or last-known employer.

INTERROGATORY NO. 12:

If Applicant contends that there is no likelihood of confusion caused by Applicant's Mark vis a vis Opposer Blue Cross and Blue Shield Association's FITBLUE Marks, please describe in detail all bases for that contention.

INTERROGATORY NO. 13:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #1, that "Applicant's mark is unique and distinctive," as pled in its Answer in this proceeding.

INTERROGATORY NO. 14:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #2, that "The wording in Applicant's mark is different from the wording in any of Opposer's marks," as pled in its Answer in this proceeding.

INTERROGATORY NO. 15:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #3, that "Applicant's mark is different in appearance from any of Opposer's marks," as pled in its Answer in this proceeding.

INTERROGATORY NO. 16:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #4, that "Applicant's mark has a different spelling from any of Opposer's marks," as pled in its Answer in this proceeding.

INTERROGATORY NO. 17:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #5, that "Applicant's mark and Opposer's marks create different commercial impressions," as pled in its Answer in this proceeding.

INTERROGATORY NO. 18:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #6, that "Applicant's mark contains the word 'FIT' not present in Opposer's marks," as pled in its Answer in this proceeding.

INTERROGATORY NO. 19:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #7, that "'FIT' is registered in trademarks for health related goods and services not owned by Opposer," as pled in its Answer in this proceeding.

INTERROGATORY NO. 20:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #8, that "'FIT' is used in commerce by third parties as part of trademark for health related goods and services," as pled in its Answer in this proceeding.

INTERROGATORY NO. 21:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #9, that "Applicant's services and Opposer's services are not marketed through the same channels of trade," as pled in its Answer in this proceeding.

INTERROGATORY NO. 22:

Please describe in detail all "channels of trade" utilized by Applicant (with the quoted phrase having the same meaning as in Applicant's allegation or defense enumerated #2, as pled in its Answer in this proceeding).

INTERROGATORY NO. 23:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #10, that "Applicant and Opposer provide different services," as pled in its Answer in this proceeding.

INTERROGATORY NO. 24:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #11, that "Applicant's mark and Opposer's marks are not likely to cause confusion, mistake or deception to purchasers as to the source of Opposer's goods or services," as pled in its Answer in this proceeding.

INTERROGATORY NO. 25:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #12, that "Applicant's mark and Opposer's marks are not likely to disparage or falsely suggest a trade connection between Opposer and Applicant," as pled in its Answer in this proceeding.

INTERROGATORY NO. 26:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #13, that "Applicant has priority and came up with the mark," as pled in its Answer in this proceeding.

INTERROGATORY NO. 27:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #14, that "Applicant was the first to use the mark in commerce," as pled in its Answer in this proceeding.

INTERROGATORY NO. 28:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #15, that "Opposer waived any rights to the mark," as pled in its Answer in this proceeding.

INTERROGATORY NO. 29:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #16, that "Applicant's mark is not likely to dilute the distinctive quality of any of Opposer's marks," as pled in its Answer in this proceeding.

INTERROGATORY NO. 30:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #17, that "Opposer's actions constituted a full release of any and all claims to the mark," as pled in its Answer in this proceeding.

INTERROGATORY NO. 31:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #18, that "The Notice of Opposition is barred by reason of acts, omissions, representations and courses of conduct by Opposer which Applicant was led to rely to its detriment," as pled in its Answer in this proceeding.

INTERROGATORY NO. 32:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #19, that "Opposer's inequitable conduct constitutes unclean hands," as pled in its Answer in this proceeding.

INTERROGATORY NO. 33:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #20, that "Opposer did not timely commence this action and it is therefore barred," as pled in its Answer in this proceeding.

INTERROGATORY NO. 34:

Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #21, that "Defects in the Notice of Opposition and in service of the Notice of Opposition are a bar to this action," as pled in its Answer in this proceeding.

INTERROGATORY NO. 35:

Please describe in detail any and all efforts Applicant undertook to investigate whether Applicant's Mark was available for Applicant's use or registration, including without limitation any trademark search or clearance work.

INTERROGATORY NO. 36:

Please describe in detail any and all instances of actual confusion between Applicant's Mark and Opposer Blue Cross and Blue Shield Association, or Opposer's FITBLUE Marks or Blue Marks.

INTERROGATORY NO. 37:

Please identify the first date on which Applicant became aware of any of Blue Cross and Blue Shield Association's Blue Marks.

INTERROGATORY NO. 38:

Please identify the individuals referenced in Applicant's Initial Disclosures in paragraph a., under the section titled FRCP 26(a)(1)(A)(i) by stating each such person's full name, title,

current or last-known address, current or last-known telephone number, current or last known e-mail address, and current or last-known employer.

INTERROGATORY NO. 39:

Please identify the individuals referenced in Applicant's Initial Disclosures in paragraph b., under the section titled FRCP 26(a)(1)(A)(i) by stating each such person's full name, title, current or last-known address, current or last-known telephone number, current or last known e-mail address, and current or last-known employer.

INTERROGATORY NO. 39:

Please describe in detail the relationship between Applicant Palladian Health, LLC and Prism Health Networks.

INTERROGATORY NO. 40:

List all other customers of Applicant for services under Applicant's Mark other than BlueCross BlueShield of Western New York and BlueShield of Northeastern New York.

INTERROGATORY NO. 41:

Identify the names, titles and contact information of all individuals at BlueCross BlueShield of Western New York and BlueShield of Northeastern New York with whom Applicant corresponded or met with respect to the FITBLUE program or Applicant's relationship with HealthNow, including but not limited to selection of Applicant, negotiations of any contracts, running of the program, newsletters, disputes, and termination, and briefly describe for each individual the related category type(s) as listed above (or as further described by Applicant).

INTERROGATORY NO. 42:

Identify all entities Applicant pitched to perform services under Applicant's Mark.

INTERROGATORY NO. 43:

State whether Applicant has pitched services under Applicant's Mark to Blue Cross Blue Shield of Arizona, and if so identify the date(s) of such pitches, the names of individuals pitched to, and all materials provided to Blue Cross Blue Shield of Arizona.

INTERROGATORY NO. 44:

State whether Applicant has pitched services under Applicant's Mark to Blue Cross and Blue Shield of Florida, or Florida Blue, and if so identify the date(s) of such pitches, the names of individuals pitched to, and all materials provided to Blue Cross and Blue Shield of Florida or Florida Blue.

INTERROGATORY NO. 45:

State whether Applicant has pitched services under Applicant's Mark to Blue Cross and Blue Shield of North Carolina, and if so identify the date(s) of such pitches, then names of individuals pitched to, and all materials provided to Blue Cross and Blue Shield of North Carolina.

INTERROGATORY NO. 46:

State whether Applicant has pitched services under Applicant's Mark to Blue Cross and Blue Shield of South Carolina, and if so identify the date(s) of such pitches, the names of individuals pitched to, and all materials provided to Blue Cross and Blue Shield of South Carolina.

INTERROGATORY NO. 47:

Describe in detail the meaning of Applicant's Mark, particularly the "BLUE" portion of Applicant's Mark.

The rest of this page left blank intentionally.

INTERROGATORY NO. 48:

Please state your understanding of the relationships between HealthNow, BlueCross BlueShield of Western New York, BlueShield of Northeastern New York, and Opposer Blue Cross and Blue Shield Association.

Dated this 11th day of January, 2013.

By: 

SUSAN G. O'NEILL, SBN115133
GARNER K. WENG, SBN191462
CHRISTOPHER S. WALTERS, SBN267262
HANSON BRIDGETT LLP
425 Market Street, 26th Floor
San Francisco, California 94105
Telephone: (415) 777-3200
Facsimile: (415) 541-9366
E-mail: soneill@hansonbridgett.com
E-mail: gweng@hansonbridgett.com
E-mail: cwalters@hansonbridgett.com

Attorneys for Opposer
Blue Cross and Blue Shield Association

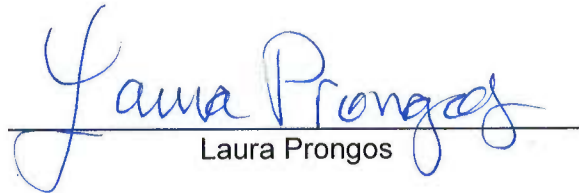
CERTIFICATE OF SERVICE

I, Laura Prongos, hereby certify that a true and complete copy of the foregoing OPPOSER BLUE CROSS AND BLUE SHIELD ASSOCIATION'S INTERROGATORIES TO APPLICANT PALLADIAN HEALTH, LLC (SET ONE) was served on the parties listed below by mailing said copies on January 11, 2013 via Overnight Delivery, postage pre-paid to:

Marybeth Priore
Colucci & Gallaher, P.C.
2000 Liberty Building
424 Main Street
Buffalo, NY 14202

Attorney for Applicant
Palladian Health, LLC

Dated: January 11, 2013



Laura Prongos

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN RE: APPLICATION SERIAL NO. 85/363,867

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

PALLADIAN HEALTH, LLC,

Applicant.

Opposition No. 91206208

**OPPOSER BLUE CROSS AND BLUE
SHIELD ASSOCIATION'S REQUESTS FOR
PRODUCTION TO APPLICANT PALLADIAN
HEALTH, LLC (SET ONE)**

PROPOUNDING PARTY: BLUE CROSS AND BLUE SHIELD ASSOCIATION

RESPONDING PARTY: PALLADIAN HEALTH, LLC

SET NO.: One

Pursuant to TBMP §§ 401 et seq., 37 C.F.R. § 2.120(a) & (d), and FRCP 34, Opposer BLUE CROSS AND BLUE SHIELD ASSOCIATION, by and through its undersigned counsel, requests that Applicant PALLADIAN HEALTH, LLC respond to this request in writing and to produce, for inspection and copying all documents and things within 30 days from service of this request (as may be properly adjusted based on the method of service under applicable rules).

DEFINITIONS

The following definitions and manners of interpretation apply to each instruction and request set forth here as if incorporated within each request.

1. The terms "relates to," "relate to," and "relating to" mean concerning, evidencing, showing, supporting, summarizing, describing, about, connected with, commenting on, addressing the subject matter of, alluding to, bearing on, consisting of, constituting, being, and referring to in any way.

2. The terms "Opposer," "Blue Cross and Blue Shield Association," "BCBSA," and "Association" refer to Opposer Blue Cross and Blue Shield Association.

3. The terms "you," "your," "Applicant," and "Palladian Health" refer to Applicant Palladian Health, LLC, including without limitation any predecessor in interest such as Prism Health Networks and its or their officers, directors, employees, attorneys, or other agents acting in the course and scope of their employment or roles with or otherwise acting on behalf of Palladian Health, LLC.

4. The term "Application" means the application for federal registration that is the subject of this proceeding, namely, Application Serial No. 85/363,867.

5. The term "Applicant's Mark" means the mark that is the subject of the Application.

6. The term "Applicant's Services" means any and all services provided under Applicant's Mark, including without limitation those listed in the Application.

7. The term "Applicant's Specimen of Use" means any and all specimens of use submitted to the U.S. Patent & Trademark Office by Applicant in connection with the Application.

8. The term "Blue Marks" means any mark used or that is the subject of a registration by Opposer Blue Cross and Blue Shield Association (including without limitation through its member plans and licensees) that consists of or includes the term BLUE or a blue-colored design element.

9. The term "FITBLUE Mark" and "FITBLUE Marks" means any mark or marks consisting of or including the term "FITBLUE" or "FIT BLUE".

10. The term "BlueCross BlueShield of Western New York" refers to BlueCross BlueShield of Western New York, a division of HealthNow New York, Inc.

11. The term "BlueShield of Northeastern New York" refers to BlueShield of Northeastern New York, a division of HealthNow New York, Inc.

12. The terms "HealthNow" and "HealthNow New York" refer to HealthNow New York, Inc.

INSTRUCTIONS

The following instructions apply to each request for production set forth here as if incorporated within each request for production.

1. In the written response, set forth each document request before each response.
2. Produce documents in your possession, custody, or control, as well as those documents reasonably available to you, including those in the possession, custody, or control of your officers, directors, attorneys, agents, representatives, employees, or other persons acting on your behalf.
3. Categorize all documents produced with respect to the specific enumerated requests to which they relate; or produce documents in the same form as they were kept prior to this request for production, including with files, folder tabs or containers, and labels. For electronic or other documents, produce the documents in their native electronic form, together with enough information about any system on which it resided and information about any applications used to create the document to render it intelligible; and please produce the file folder, tabs or containers, and labels appended to or associated with any physical storage device or media.
4. If any part of a document is responsive to the request, produce the entire document.
5. If you are able to produce only some of the documents responsive to the request, produce all documents possible and identify those documents you are unable to produce and the reasons for the inability to produce them.
6. If you object to a portion of the request, produce all documents called for by the portion of the request to which you do not object.
7. For each document withheld on the grounds of privilege, or other grounds, provide a written response with the following information: (a) the date, author, sender, and recipient of the document; (b) the title of and a description of the document sufficiently particular

to identify it for purposes of a Board order; (c) the nature of the protection claimed; and (d) the factual basis for the protection claimed sufficient to permit the Board to adjudicate the validity of the claim.

8. If you contend that only a portion of a document is privileged or otherwise not subject to production, produce a copy of the entire document with the portion that you claim is privileged or otherwise not subject to production redacted. In each such case, with respect to the deleted portion of the document, provide a written response with the following information: (a) the title of and a description of the information redacted sufficiently particular to identify it for purposes of a Board order; (b) the nature of the protection claimed; and (c) the factual basis for the protection claimed sufficient to permit the Board to adjudicate the validity of the claim.

9. If you have knowledge of the existence of documents responsive to the request but contend that they are not within your possession, custody or control, for each such document, provide a written response with the following information: (a) the date, author, sender, and recipient of the document; (b) the title of and a description of the document sufficiently particular to identify it for purposes of a Board order; (c) the number of pages comprising the document; (d) a specific description of the contents and form of the document; and (e) any information on who may currently have possession, custody, or control of the document.

10. For each document responsive to the request that has been lost or destroyed, provide a written response with the following information: (a) the date, author, sender, and recipient of the document; (b) the title of and a description of the document sufficiently particular to identify it for purposes of a Board order; (c) the approximate date on which the loss or destruction occurred; (d) the manner in which the loss or destruction occurred; (e) the reason for the destruction; (f) a specific description of the contents and form of the document; and (g) any information on who may still have a copy of the document.

11. Each request will be deemed to be continuing so as to require prompt supplementation of responses and production as provided by the Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Manual of Procedure.

REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 1:

All documents and things constituting, evidencing, or relating to any agreements between Applicant and HealthNow New York, Inc. addressing, covering, involving, or in any way relating to FITBLUE, Applicant's Services under Applicant's Mark, or the website at www.fitblue.com.

REQUEST FOR PRODUCTION NO. 2:

All documents and things constituting, evidencing, or relating to any agreements between Applicant and HealthNow New York, Inc. addressing, covering, involving, or in any way relating to services described in the Application or Applicant's Specimen of Use.

REQUEST FOR PRODUCTION NO. 3:

All documents and things constituting, evidencing, or relating to any communications between Applicant and HealthNow New York, Inc. mentioning, referring to, or in any way relating to FITBLUE, Applicant's Services under Applicant's Mark, or the website at www.fitblue.com.

REQUEST FOR PRODUCTION NO. 4:

All documents and things constituting, evidencing, or relating to any communications between Applicant and HealthNow New York, Inc. mentioning, referring to, or in any way relating to services described in the Application or Applicant's Specimen of Use.

REQUEST FOR PRODUCTION NO. 5:

All documents and things constituting or evidencing any Management Services Agreements between Applicant and HealthNow New York, Inc.

REQUEST FOR PRODUCTION NO. 6:

All documents and things constituting or evidencing any Management Services Agreements between Applicant and HealthNow New York, Inc.

REQUEST FOR PRODUCTION NO. 7:

All documents and things evidencing or relating to Applicant's Answer in these proceedings.

REQUEST FOR PRODUCTION NO. 8:

All documents and things evidencing or relating to Applicant's denial of any allegation in the Notice of Opposition, as pled in its Answer in this proceeding.

REQUEST FOR PRODUCTION NO. 9:

All documents and things evidencing or relating to Applicant's allegations or defenses, as pled in its Answer in this proceeding.

REQUEST FOR PRODUCTION NO. 10:

All documents and things constituting, evidencing, or relating to the documents identified in Applicant's Initial Disclosures in this proceeding.

REQUEST FOR PRODUCTION NO. 11:

All "Documents associated with Applicant's federal trademark application," as referenced in Applicant's Initial Disclosures in this proceeding.

REQUEST FOR PRODUCTION NO. 12:

All "Documents reflecting Applicant's creation and first use of its mark," as referenced in Applicant's Initial Disclosures in this proceeding.

REQUEST FOR PRODUCTION NO. 13:

All "Documents reflecting Applicant's services and goods," as referenced in Applicant's Initial Disclosures in this proceeding.

REQUEST FOR PRODUCTION NO. 14:

All "Documents reflecting Opposer's services and goods," as referenced in Applicant's Initial Disclosures in this proceeding.

REQUEST FOR PRODUCTION NO. 15:

All "Documents reflecting third party use and registration of marks containing the word[] BLUE," as referenced in Applicant's Initial Disclosures in this proceeding.

REQUEST FOR PRODUCTION NO. 16:

All documents and things constituting or relating to Applicant's creation, consideration, design, development, selection, or adoption of Applicant's Mark.

REQUEST FOR PRODUCTION NO. 17:

All documents and things constituting or relating to Applicant's registration or attempts to register Applicant's Mark.

REQUEST FOR PRODUCTION NO. 18:

All documents and things constituting or relating to Applicant's conducting any searches or other due diligence regarding Applicant's Mark, including without limitation all documents and things relating to the availability of Applicant's Mark for use or registration.

REQUEST FOR PRODUCTION NO. 19:

All documents and things constituting or relating to market studies or surveys that relate to the adoption or use of Applicant's Mark in commerce.

REQUEST FOR PRODUCTION NO. 20:

All documents and things constituting or relating to market studies, market reports, or surveys relating to Applicant's Mark.

REQUEST FOR PRODUCTION NO. 21:

Representative samples of all instances, manners, and ways in which Applicant's Mark has been used in connection with offering or selling goods or services by Applicant, including

without limitation images of products, packaging, labels, tags, wrappers, containers, advertisements, promotional materials, internet websites, or brochures.

REQUEST FOR PRODUCTION NO. 22:

Documents or things sufficient to show all types of goods or services offered by Applicant under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 23:

All documents and things constituting or relating to the dates of first use and first use in commerce by Applicant of Applicant's Mark.

REQUEST FOR PRODUCTION NO. 24:

All documents and things constituting or relating to correspondence with any advertising or sales agent related to Applicant's Mark.

REQUEST FOR PRODUCTION NO. 25:

All documents and things constituting or relating to press releases or news articles appearing in or on any media which refer to services under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 26:

All documents and things constituting or relating to Applicant's past, present, or future marketing plans involving Applicant's Mark.

REQUEST FOR PRODUCTION NO. 27:

All documents and things evidencing or relating to any websites that display Applicant's Mark, including without limitation any past, historical, or archival versions of such website(s).

REQUEST FOR PRODUCTION NO. 28:

All documents and things evidencing or relating to the recipients of the newsletter or other publication shown in Applicant's Specimen of Use submitted with the Application.

REQUEST FOR PRODUCTION NO. 29:

All documents and things related to Applicant's awareness of Opposer Blue Cross and Blue Shield Association (or any of its member plans or licensees).

REQUEST FOR PRODUCTION NO. 30:

All documents and things related to Applicant's awareness of any of Opposer Blue Cross and Blue Shield Association's Blue Marks or FITBLUE Marks.

REQUEST FOR PRODUCTION NO. 31:

All documents and things concerning any consideration of or analysis by Applicant regarding any Blue Cross and Blue Shield Association's Blue Marks or FITBLUE Marks.

REQUEST FOR PRODUCTION NO. 32:

All documents and things evidencing or relating to the geographic areas where Applicant offers or sells Applicant's Services under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 33:

All documents and things evidencing or relating to the channels of trade in which Applicant offers or sells Applicant's Services under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 34:

All documents and things evidencing or relating to the class of customers for Applicant's Services offered under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 35:

All documents and things evidencing or relating to the identity of Applicant's potential customers who receive or see Applicant's advertising or other promotion using Applicant's Mark.

REQUEST FOR PRODUCTION NO. 36:

All documents and things evidencing, relating to, or analyzing any visitors of any websites that display Applicant's Mark.

REQUEST FOR PRODUCTION NO. 37:

All documents and things constituting or relating to any and all instances of actual confusion between Applicant's Mark and Opposer Blue Cross and Blue Shield Association's FITBLUE Marks.

REQUEST FOR PRODUCTION NO. 38:

All documents and things constituting or relating to any and all instances of actual confusion between Applicant's Mark and Opposer Blue Cross and Blue Shield Association's Blue Marks.

REQUEST FOR PRODUCTION NO. 39:

All documents and things evidencing or relating to Applicant's responses to Interrogatories (Set One), including without limitation all documents and things reviewed or relied upon by Applicant in preparing its responses.

REQUEST FOR PRODUCTION NO. 40:

All documents and things evidencing or relating to Applicant's responses to Requests for Admission (Set One), including without limitation all documents and things reviewed or relied upon by Applicant in preparing its responses.

REQUEST FOR PRODUCTION NO. 41:

All documents and things relating to the meaning or connotation of Applicant's Mark, particularly the "BLUE" portion of Applicant's Mark.

REQUEST FOR PRODUCTION NO. 42:

All documents and things relating to any communications with or marketing pitches to the following: Blue Cross Blue Shield of Arizona, Blue Cross and Blue Shield of Florida or Florida Blue, Blue Cross and Blue Shield of North Carolina, and Blue Cross and Blue Shield of South Carolina relating to Applicant's Mark, including the goods and services offered in connection with Applicant's Mark.

REQUEST FOR PRODUCTION NO. 43:

Documents showing the identity of all other customers of Applicant for services offered in connection with Applicant's Mark other than HealthNow.

REQUEST FOR PRODUCTION NO. 44:

Documents relating to the relationship between Applicant Palladian Health, LLC and Prism Health Networks.

REQUEST FOR PRODUCTION NO. 45:

Copies of all marketing pitch packages to any entities relating to Applicant's Mark, including the goods and services offered in connection with Applicant's Mark.

Dated this 11th day of January, 2013.

By: 

SUSAN G. O'NEILL, SBN115133
GARNER K. WENG, SBN191462
CHRISTOPHER S. WALTERS, SBN267262
HANSON BRIDGETT LLP
425 Market Street, 26th Floor
San Francisco, California 94105
Telephone: (415) 777-3200
Facsimile: (415) 541-9366
E-mail: soneill@hansonbridgett.com
E-mail: gweng@hansonbridgett.com
E-mail: cwalters@hansonbridgett.com

Attorneys for Opposer
Blue Cross and Blue Shield Association

CERTIFICATE OF SERVICE

I, Laura Prongos, hereby certify that a true and complete copy of the foregoing OPPOSER BLUE CROSS AND BLUE SHIELD ASSOCIATION'S REQUESTS FOR PRODUCTION TO APPLICANT PALLADIAN HEALTH, LLC (SET ONE) was served on the parties listed below by mailing said copies on January 11, 2013 via Overnight Delivery, postage pre-paid to:

Marybeth Priore
Colucci & Gallaher, P.C.
2000 Liberty Building
424 Main Street
Buffalo, NY 14202

Attorney for Applicant
Palladian Health, LLC

Dated: January 11, 2013



Laura Prongos

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

vs.

PALLADIAN HEALTH, LLC,

Applicant.

*
*
*
* OPPOSITION NO. 91206208
*
* MARK: FITBLUE
*
* APPLICATION NO. 85363867
*
*
*

RESPONSE TO OPPOSER'S INTERROGATORIES

The applicant, Palladian Health, LLC, by and through its attorneys, Colucci & Gallaher, P.C., for its response to applicant Blue Cross and Blue Shield Association's Interrogatories, states as follows:

GENERAL OBJECTIONS AND RESERVATIONS

Unless otherwise indicated, the following objections apply to each of the interrogatories:

1. The applicant objects to the interrogatories to the extent that they purport to require disclosure of information beyond the permissible scope of discovery. The applicant's responses and identification of any documents included therein shall not waive or prejudice any objections the applicant may later assert, including but not limited to objections as to admissibility of any responses included herein or documents or categories of documents identified in the responses included herein, at trial.

2. The applicant objects to the interrogatories to the extent that they purport to require the disclosure of information prepared in anticipation of litigation, subject to the claim of privilege or protected from discovery under the attorney work product doctrine.

Any inadvertent identification or production of documents subject to such privilege shall not waive those privileges.

3. The applicant objects to each of opposer's interrogatories which purport to request information that calls for the premature disclosure of expert testimony.

4. The applicant objects to the interrogatories to the extent that they are redundant and repetitive.

5. The applicant objects to the interrogatories as being overbroad and unduly burdensome, oppressive and calling for unbounded discovery.

6. The applicant objects to the interrogatories to the extent that they are not reasonably calculated to lead to discovery of admissible evidence.

7. The applicant objects to the interrogatories to the extent they seek information not material and/or necessary to the prosecution and/or defense of this action.

8. The applicant objects to the interrogatories to the extent that same seek information that is known by, or available with equal or greater facility to the opposer, its agents, servants and/or employees.

9. The applicant objects to those portions of the interrogatories that request the applicant to identify documents that are within the custody and/or control of the opposer, its agents, servants and/or employees and/or not within the custody and control of the applicant.

10. The applicant does not waive any objection to the admissibility, competency, relevancy, materiality, confidentiality or privilege attaching to any document, communication or information, or the right to object to any discovery, request or undertakings involving or relating to the subject matter of the interrogatories herein.

11. The applicant expressly reserves the right to amend and supplement the responses with respect to additional information, material and documents supplied or obtained in the course of discovery herein.

12. Subject to the above general objections and reservations, which applicant hereby incorporates into each response hereby given, the applicant responds to the interrogatories and requests for production of documents as follows:

RESPONSES

Interrogatory 1: Please describe in detail all goods and services offered by Applicant under Applicant's Mark.

Response to Interrogatory 1: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, FITBLUE is used with the following services offered by Applicant: Administration of health benefit plans concerning fitness center memberships; promoting enrollment in fitness centers to health benefit plan members.

Interrogatory 2: Please describe in detail the relationship between BlueCross and BlueShield of Western New York's FITBLUE program as described on www.fitblue.com and Applicant's Services under Applicant's Mark.

Response to Interrogatory 2: Applicant objects to this interrogatory because it is vague and ambiguous. Subject to and without waiving this objection, Applicant's services are offered through fitblue.com.

Interrogatory 3: State the dates of Applicant's relationship with HealthNow, including beginning date, date of execution of any contracts and termination of relationship dates.

Response to Interrogatory 3: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it seeks information that is irrelevant, immaterial and not reasonably calculated to lead to otherwise admissible evidence. Subject to and without waiving these objections, relevant to this matter, Applicant entered into the Prism Fitblue Services Agreement (“FITBLUE Agreement”) with HealthNow New York, Inc. (“HealthNow”) on January 1, 2007. The FITBLUE Agreement was executed by Applicant on May 9, 2008 and by HealthNow on May 12, 2008. The FITBLUE Agreement was terminated on December 31, 2012.

Interrogatory 4: Please describe in detail to whom the publication shown in Applicant’s Specimen of Use is disseminated.

Response to Interrogatory 4: Applicant objects to this interrogatory because it is vague and ambiguous. Subject to and without waiving this objection, Applicant’s Specimen of Use was shown to FITBLUE members enrolled in BlueCross BlueShield of Western New York’s Medicare Advantage Plans.

Interrogatory 5: Please describe in detail who are “FitBlue members” (as that term is used in Applicant’s Specimen of Use and on the website at www.fitblue.com).

Response to Interrogatory 5: Applicant objects to this interrogatory because it is vague and ambiguous. Subject to and without waiving this objection, FITBLUE members are Medicare-related program members.

Interrogatory 6: Please describe in detail all uses of Applicant’s Mark by Applicant that have not in any way involved BlueCross BlueShield of Western New York or BlueShield of Northeastern New York.

Response to Interrogatory 6: Applicant objects to this interrogatory because it is vague and ambiguous. Subject to and without waiving this objection, to date, none.

Interrogatory 7: Please describe in detail all geographic areas in which Applicant provides Applicant's Services under Applicant's Mark.

Response to Interrogatory 7: Applicant objects to this interrogatory because it is vague and ambiguous. Subject to and without waiving this objection, New York State.

Interrogatory 8: For each geographic area identified in your answer to the immediately preceding interrogatory, please state the date of Applicant's first use of Applicant's Mark in commerce.

Response to Interrogatory 8: January 1, 2007.

Interrogatory 9: Please identify each person involved in the creation of Applicant's Mark, including by stating each such person's full name, title, current or last-known address, current or last-known telephone number, current or last-known e-mail address, current or last-known employer, and employer at the time he or she was involved in the creation of design of Applicant's Mark.

Response to Interrogatory 9: Applicant objects to this interrogatory because it is vague and ambiguous. Subject to and without waiving this objection, Mark Zygaj, Executive Vice President and Chief Operating Officer at Palladian Health, LLC, 2732 Transit Road, West Seneca, New York.

Interrogatory 10: For each person identified in the response to the immediately preceding interrogatory, please describe in detail the person's role, responsibilities, and contributions to or regarding Applicant's Mark.

Response to Interrogatory 10: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Mark Zygaj created and developed the FITBLUE mark.

Interrogatory 11: Please identify each person who was responsible for selecting Applicant's Mark for use with Applicant's Services, including by stating such person's full name, title, current or last-known address, current or last-known telephone number, current or last known e-mail address, and current or last-known employer.

Response to Interrogatory 11: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant does not know the name of every person who took part in selecting FITBLUE for use with Applicant's services. Mark Zygaj has knowledge concerning the use of FITBLUE with Applicant's services.

Interrogatory 12: If Applicant contends that there is no likelihood of confusion caused by Applicant's Mark vis a vis Opposer Blue Cross and Blue Shield Associations' FITBLUE Marks, please describe in detail all bases for that contention.

Response to Interrogatory 12: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Applicant refers you to its Answer and Affirmative Defenses.

Interrogatory 13: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #1, that "Applicant's mark is unique and distinctive," as pled in its Answer in this proceeding.

Response to Interrogatory 13: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, among other things, the wording in Applicant's mark is different from the wording in any of Opposer's marks, Applicant's mark is different in appearance from any of Opposer's marks, Applicant's mark has a different spelling from any of Opposer's marks, Applicant's mark and Opposer's marks create different commercial impressions, and Applicant's mark contains the word "FIT" not present in Opposer's marks.

Interrogatory 14: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #2, that "The wording in Applicant's mark is different from the wording in any of Opposer's marks," as pled in its Answer in this proceeding.

Response to Interrogatory 14: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Applicant's mark contains the word "FIT" not present in Opposer's marks.

Interrogatory 15: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #3, that "applicant's mark is different in appearance from any Opposer's marks," as pled in its Answer in this proceeding.

Response to Interrogatory 15: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects

to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Applicant's mark contains the word "FIT" not present in Opposer's marks.

Interrogatory 16: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #4, that "Applicant's mark has a different spelling from any of Opposer's marks," as pled in its Answer in this proceeding.

Response to Interrogatory 16: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Applicant's mark contains the word "FIT" not present in Opposer's marks.

Interrogatory 17: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #5, that "Applicant's mark and Opposer's marks create different commercial impressions," as pled in its Answer in this proceeding.

Response to Interrogatory 17: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Applicant's mark contains the word "FIT" not present in Opposer's marks. The word "FIT" conveys a commercial impression related to Applicant's services, including: Administration of health benefit plans concerning fitness center memberships; promoting enrollment in fitness centers to health benefit plan members

Interrogatory 18: Please describe in detail all factual and legal bases for

Applicant's allegation or defense enumerated #6, that "Applicant's mark contains the word 'FIT' not present in Opposer's marks," as pled in its Answer in this proceeding.

Response to Interrogatory 18: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, this statement speaks for itself.

Interrogatory 19: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #7, that "FIT" is registered in trademarks for health related goods and services not owned by Opposer," as pled in its Answer in this proceeding.

Response to Interrogatory 19: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, this statement speaks for itself.

Interrogatory 20: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #8, that "FIT" is used in commerce by third parties as part of trademark for health related goods and services," as pled in its Answer in this proceeding.

Response to Interrogatory 20: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, this statement speaks for itself.

Interrogatory 21: Please describe in detail all factual and legal bases for

Applicant's allegation or defense enumerated #9, that "Applicant's services and Opposer's services are not marketed through the same channels of trade," as pled in its Answer in this proceeding.

Response to Interrogatory 21: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Applicant's services, to date, have only been marketed in New York State.

Interrogatory 22: Please describe in detail all "channels of trade" utilized by Applicant (with the quoted phrase having the same meaning as in Applicant's allegation or defense enumerated #2, as pled in its Answer in this proceeding).

Response to Interrogatory 22: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion.

Interrogatory 23: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #10, that "Applicant and Opposer provide different services," as pled in its Answer in this proceeding.

Response to Interrogatory 23: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Opposer's services do not include: Administration of health benefit plans concerning fitness center memberships, fitness center credentialing and network management, claims payment to fitness centers, customer service to fitness

center providers and members accessing fitness programs, and production and distribution of participant identification cards and program descriptions/instructions for use.

Interrogatory 24: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #11, that Applicant's mark and Opposer's marks are not likely to cause confusion, mistake or deception to purchasers as to the source of Opposer's goods or services," as pled in its Answer in this proceeding.

Response to Interrogatory 24: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, this statement speaks for itself.

Interrogatory 25: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #12, that "Applicant's mark and Opposer's marks are not likely to disparage or falsely suggest a trade connection between Opposer and Applicant," as pled in its Answer in this proceeding.

Response to Interrogatory 25: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, this statement speaks for itself.

Interrogatory 26: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #13, that "Applicant has priority and came up with the mark," as pled in its Answer in this proceeding.

Response to Interrogatory 26: Applicant objects to this interrogatory because

it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Applicant created Applicant's Mark and was the first to use it in commerce.

Interrogatory 27: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #14, that "Applicant was the first to use the mark in commerce," as pled in its Answer in this proceeding.

Response to Interrogatory 27: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, this statement speaks for itself.

Interrogatory 28: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #15, that "Opposer waived any rights to the mark," as pled in its Answer in this proceeding.

Response to Interrogatory 28: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, Opposer was aware that Applicant created Applicant's mark and was the first to use it commerce through its licensee HealthNow and never objected to Applicant's use of the mark prior to instituting this proceeding.

Interrogatory 29: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #16, that "Applicant's mark is not likely to dilute the distinctive quality of any of Opposer's marks," as pled in its Answer in this

proceeding.

Response to Interrogatory 29: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, this statement speaks for itself.

Interrogatory 30: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #17, that "Opposer's actions constituted a full release of any and all claims to the mark," as pled in its Answer in this proceeding.

Response to Interrogatory 30: See response to interrogator 28,

Interrogatory 31: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #18, that "The Notice of Opposition is barred by reason of acts, omissions, representations and courses of conduct by Opposer which Applicant was led to rely in its detriment," as pled in its Answer in this proceeding.

Response to Interrogatory 31: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion.

Interrogatory 32: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #19, that "Opposer's inequitable conduct constitutes unclean hands," as pled in its Answer in this proceeding.

Response to Interrogatory 32: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion.

Interrogatory 33: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #20, that "Opposer did not timely commence in this action and it is therefore barred," as pled in its Answer in this proceeding.

Response to Interrogatory 33: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion.

Interrogatory 34: Please describe in detail all factual and legal bases for Applicant's allegation or defense enumerated #21, that "Defects in the Notice of Opposition and in service of the Notice of Opposition are a bar to this action," as pled in its Answer in this proceeding.

Response to Interrogatory 34: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion.

Interrogatory 35: Please describe in detail any and all efforts Applicant undertook to investigate whether Applicant's Mark was available for Applicant's use or registration, including without limitation any trademark search or clearance work.

Response to Interrogatory 35: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it seeks information protected by the attorney-client privilege and work product doctrine.

Interrogatory 36: Please describe in detail any and all instances of actual confusion between Applicant's Mark and Opposer Blue Cross and Blue Shield

Association, or Opposer's FITBLUE Marks or Blue Marks.

Response to Interrogatory 36: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this interrogatory because it is premature and asks for a legal conclusion. Subject to and without waiving this objection, none.

Interrogatory 37: Please identify the first date on which Applicant became aware of any of Blue Cross and Blue Shield Association's Blue Marks.

Response to Interrogatory 37: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant has not been provided with a list of the Blue Marks.

Interrogatory 38: Please identify the individuals referenced in Applicant's Initial Disclosures in paragraph a., under the section titled FRCP 26(a)(1)(A)(i) by stating each such person's full name, title, current or last-known address, current or last-known telephone number, current or last-known e-mail address, and current or last-known employer.

Response to Interrogatory 38: See response to interrogatory 9.

Interrogatory 39: Please describe in detail the relationship between Applicant Palladian Health, LLC and Prism Health Networks.

Response to Interrogatory 39: Prism Health Networks changed its name to Palladian Health, LLC on or about May 30, 2008.

Interrogatory 40: List all other customers of Applicant for services under Applicant's Mark other than BlueCross BlueShield of Western New York and BlueShield of Northeastern New York.

Response to Interrogatory 40: None.

Interrogatory 41: Identify the names, titles and contact information of all individuals at BlueCross BlueShield of Northeastern New York with whom Applicant corresponded or met with respect to the FITBLUE program or Applicant's relationship with HealthNow, including but not limited to selection of Applicant, negotiations of any contracts, running of the program, newsletters, disputes, and termination, and briefly describe for each individual the related category type(s) as listed above (or as further described by the Applicant).

Response to Interrogatory 41: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant does not know the name of all individuals at BlueCross BlueShield of Northeastern New York with whom Applicant corresponded or met with respect to the FITBLUE. Applicant does recall Kim Barker, Kerri Garrison, Christian Miller, Greg Pasieka, Nancy Janek and Cathy Campbell.

Interrogatory 42: Identify all entities Applicant pitched to perform services under Applicant's Mark.

Response to Interrogatory 42: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome.

Interrogatory 43: State whether Applicant has pitched services under Applicants Mark to Blue Cross Blue Shield of Arizona, and if so identify the date(s) of such pitches, the names of individuals pitched to, and all materials provided to Blue Cross Blue Shield of Arizona.

Response to Interrogatory 43: Applicant objects to this interrogatory because

it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, no.

Interrogatory 44: State whether the Applicant has pitched services under Applicant's Mark to Blue Cross and Blue Shield of Florida, or Florida Blue, and if so identify the date(s) of such pitches, the names of individuals pitched to, and all materials provided to Blue Cross and Blue Shield of Florida or Florida Blue.

Response to Interrogatory 44: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant has pitched services to Blue Cross and Blue Shield of Florida.

Interrogatory 45: State whether Applicant has pitched services under Applicant's Mark to Blue Cross and Blue Shield of North Carolina, and if so identify the date(s) of such pitches, then names of individuals pitched to, and all materials provided to Blue Cross and Blue Shield of North Carolina.

Response to Interrogatory 45: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant has pitched services to Blue Cross and Blue Shield of North Carolina.

Interrogatory 46: State whether Applicant has pitched services under Applicant's Mark to Blue Cross and Blue Shield of South Carolina, and if so identify the date(s) of such pitches, the names of individuals pitched to, and all materials provided to Blue Cross and Blue Shield of South Carolina.

Response to Interrogatory 46: Applicant objects to this interrogatory because


it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant has pitched services to Blue Cross and Blue Shield of South Carolina.

Interrogatory 47: Describe in detail the meaning of Applicant's Mark, particularly the "BLUE" portion of Applicant's Mark.

Response to Interrogatory 47: Applicant objects to this interrogatory because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, the meaning of Applicant's mark is related to its services being provided under the mark, including Administration of health benefit plans concerning fitness center memberships; promoting enrollment in fitness centers to health benefit plan members.

DATED: April 18, 2013

COLUCCI & GALLAHER, P.C.



Marybeth Priore
2000 Liberty Building
Buffalo, New York 14202
Phone: (716) 853-4080
Attorneys for Applicant
Palladian Health, LLC

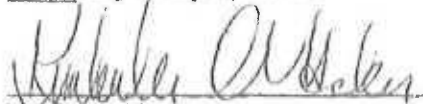
CORPORATE VERIFICATION

STATE OF NEW YORK)
) ss:
COUNTY OF ERIE)

Mark R. Zygaaj, being duly sworn, deposes and says that he is the Executive Vice President and Chief Operating Officer of Palladian Health, LLC; that deponent has read the foregoing Response to Response to Opposer's Interrogatories and knows the contents thereof and that the same is true to deponent's own knowledge, except as to the matters therein stated to be alleged upon information and belief, and that as to those matters, deponent believes them to be true.


Mark R. Zygaaj

Sworn to before me this
16th day of April, 2013.


Notary Public

Kimberlee A. Hacker
Notary Public, State of New York
Qualified in Erie County
My Commission Expires August 20, 2015

CERTIFICATE OF SERVICE

I, Marybeth Priore, hereby certify that a true and complete copy of the foregoing paper on the parties listed below, by mailing said copies on April 18, 2013, via U.S. First Class Mail, postage pre-paid to:

Susan G. O'Neill, Esq.
Garner K. Weng, Esq.
Christopher S. Walters, Esq.
Hanson Bridgett, LLP
425 Market Street, 26th Floor
San Francisco, California 94105



Marybeth Priore

EXHIBIT D

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

vs.

PALLADIAN HEALTH, LLC,

Applicant.

*
*
*
* OPPOSITION NO. 91206208
*
* MARK: FITBLUE
*
* APPLICATION NO. 85363867
*
*
*

RESPONSE TO OPPOSER'S REQUESTS FOR PRODUCTION

The Applicant, Palladian Health, LLC, by and through its attorneys, Colucci & Gallaher, P.C., for its response to Opposer, Blue Cross and Blue Shield Association's, Requests for Production, states as follows:

Request 1: All documents and things constituting, evidencing, or relating to any agreements between Applicant and HealthNow New York, Inc. addressing, covering, involving, or in any way relating to FITBLUE, Applicant's Services under Applicant's Mark, or the website at www.fitblue.com.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant identifies copies of the following:

- a. Prism Fitblue Services Agreement, identified on the enclosed CD as Exhibit A;
- b. First Amendment to Fitblue Services Agreement, identified on the enclosed CD as Exhibit B; and
- c. Second Amendment to the Fitblue Services Agreement, identified on the enclosed CD as Exhibit C.

Request 2: All documents and things constituting, evidencing, or relating to any communications between Applicant and HealthNow New York, Inc. addressing, covering, involving, or in any way relating to services described in the Application or Applicant's Specimen of Use.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it seeks information which is irrelevant, immaterial and not likely to lead to otherwise admissible evidence.

Request 3: All documents and things constituting, evidencing, or relating to any communications between Applicant and HealthNow New York, Inc. mentioning, referring to, or in any way relating to FITBLUE, Applicant's Services under Applicant's Mark, or the website at www.fitblue.com.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of request 2. Subject to and without waiving this objection, see response to request 2.

Request 4: All documents and things constituting, evidencing, or relating to any communications between Applicant and HealthNow New York, Inc. mentioning, referring to, or in any way relating to services described in the Application or Applicant's Specimen of Use.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of requests 2 and 3. Subject to and without waiving this objection, see

response to request 2.

Request 5: All documents and things constituting or evidencing any Management Services Agreements between Applicant and HealthNow New York, Inc.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of request 1. Subject to and without waiving this objection, see response to request 1.

Request 6: All documents and things constituting or evidencing any Management Services Agreements between Applicant and HealthNow New York, Inc.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of requests 1 and 5. Subject to and without waiving this objection, see response to request 1.

Request 7: All documents and things evidencing or relating to Applicant's Answer in these proceedings.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome.

Request 8: All documents and things evidencing or relating to Applicant's denial of any allegation in the Notice of Opposition, as pled in its Answer in this proceeding.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome.

Request 9: All documents and things evidencing or relating to Applicant's

allegations or defenses, as pled in its Answer in this proceeding.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome.

Request 10: All documents and things constituting, evidencing, or relating to the documents identified in Applicant's Initial Disclosures in this proceeding.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of requests 11 through 15. Subject to and without waiving this objection, see responses to requests 11 through 15.

Request 11: All "Documents associated with Applicant's federal trademark application," as referenced in Applicant's Initial Disclosures in this proceeding.

Response: Applicant objects to this request because the materials requests are publicly available. Subject to and without waiving this objection, Applicant refers you to the materials on file with the USPTO.

Request 12: All "Documents reflecting Applicant's creation and first use of its mark," as references in Applicant's Initial Disclosures in this proceeding.

Response: Applicant objects to this request because it is overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant identifies the following:

- a. Invoice from Stand Advertising, dated September 8, 2006, regarding Fitblue logo, identified on the enclosed CD as Exhibit P;
- b. Invoice from Stand Advertising, dated September 8, 2006, regarding Fitblue postcard, identified on the enclosed CD as Exhibit Q;
- c. Fitblue Proposal, dated August 16, 2006, identified on the enclosed CD as Exhibit R;

- d. Email from Stand Advertising, dated September 15, 2006, with two attachments, identified collectively as Exhibit S;
- e. Fitblue Senior Fitness Club Membership, NENY, identified on the enclosed CD as Exhibit T;
- f. Fitblue Senior Fitness Club Membership, WNY, identified on the enclosed CD as Exhibit U;
- g. Correspondence from HealthNow, dated August 29, 2006, identified on the enclosed CD as Exhibit X; and
- h. Correspondence from Prism Health Networks, dated August 31, 2006, identified on the enclosed CD as Exhibit Y.

Request 13: All "Documents reflecting Applicant's services and goods," as referenced in Applicant's Initial Disclosures in this proceeding.

Response: Applicant objects to this request because it is overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant refers you to Exhibits A through C. In addition, Applicant identifies the following:

- a. Fitblue Program Guidelines, identified on the enclosed CD as Exhibit D;
- b. Fitblue Program Guidelines, December 2010, identified on the enclosed CD as Exhibit E;
- c. Fitblue plus Program Addendum/Acupuncture and Massage Therapy, identified on the enclosed CD as Exhibit F;
- d. Fitblue Program Addendum, identified on the enclosed CD as Exhibit G;
- e. Fitblue plus Program Guidelines, identified on the enclosed CD as Exhibit H;
- f. Fitblue plus Program Addendum/Chiropractic Services, identified on the enclosed CD as Exhibit I;
- g. Fitblue Winter 2009 Newsletter, identified on the enclosed CD as Exhibit J;
- h. Fitblue Spring 2010 Newsletter, identified on the enclosed CD as

Exhibit K;

- i. Fitblue Summer 2010 Newsletter, identified on the enclosed CD as Exhibit L;
- j. Fitblue Fall 2010 Newsletter, identified on the enclosed CD as Exhibit M;
- k. Fitblue Summer 2011 Newsletter, identified on the enclosed CD as Exhibit N;
- l. Fitblue Winter 2012 Newsletter, identified on the enclosed CD as Exhibit O;

Request 14: All “Documents reflecting Opposer’s services and goods,” as referenced in Applicant’s Initial Disclosures in this proceeding.

Response: Applicant objects to this request because it is overbroad and unduly burdensome. In addition, Applicant objects to this request because the materials are in the possession of the Opposer.

Request 15: All “Documents reflecting third party use and registration of marks containing the word [] BLUE,” as referenced in Applicant’s Initial Disclosures in this proceeding.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because the materials are publicly available. Further, Applicant objects to this mark because it seeks materials protected by the attorney work product doctrine.

Request 16: All documents and things constituting or relating to Applicant’s creation, consideration, design, development, selection, or adoption of Applicant’s Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because

it is repetitive of request 12. Subject to and without waiving this objection, see response to request 12.

Request 17: All documents and things constituting or relating to Applicant's registration or attempts to register Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of request 11. Subject to and without waiving these objections, Applicant refers you to the materials on file with the USPTO.

Request 18: All documents and things constituting or relating to Applicant's conducting any searches or other due diligence regarding Applicant's Mark, including but without limitation all documents and things relating to the availability of Applicant's Mark for use or registration.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it seeks information protected by the attorney-client privilege and/or work product doctrine.

Request 19: All documents and things constituting or relating to market studies or surveys that relate to the adoption or use of Applicant's Mark in commerce.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 20: All documents and things constituting or relating to market studies, market reports, or surveys relating to Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of request 19. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 21: Representative samples of all instances, manners, and ways in which Applicant's Mark has been used in connection with offering or selling goods or services by Applicant, including without limitation images of products, packaging, labels, tags, wrappers, containers, advertisements, promotional materials, internet websites, or brochures.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, see responses to requests 12 and 13.

Request 22: Documents or things sufficient to show all types of goods or services offered by Applicant under Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of request 13. Subject to and without waiving this objection, see response to request 13.

Request 23: All documents and things constituting or relating to the dates of first use and first use in commerce by Applicant of Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it is repetitive of request 12. Subject to and without waiving this objection, see response

to request 12.

Request 24: All documents and things constituting or relating to correspondence with any advertising or sales agent related to Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, see response to request 12.

Request 25: All documents and things constituting or relating to press releases or news articles appearing in or on any media which refer to services under Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because the information requested is publicly available. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 26: All documents and things constituting or relating to Applicant's past, present, or future marketing plans involving Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, see response to requests 12 and 13. In addition, a Fitblue magnet layout is identified on the enclosed CD as Exhibit V.

Request 27: All documents and things evidencing or relating to any websites that display Applicant's Mark, including but without limitation any past, historical, or archival versions of such website(s).

Response: Applicant objects to this request because it is vague, ambiguous,

overbroad and unduly burdensome. In addition, Applicant objects to this request because the information requested is publicly available. Subject to and without waiving this objection, Applicant refers you to www.fitblue.com. In addition, a sample page of the website is attached as Exhibit W.

Request 28: All documents and things evidencing or relating to the recipients of the newsletter or other publication shown in Applicant's Specimen of Use submitted with the Application.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, see response to request 13.

Request 29: All documents and things related to Applicant's awareness of Opposer Blue Cross and Blue Shield Association (or any of its member plans or licensees).

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it seeks information which is irrelevant, immaterial and not reasonably calculated to lead to otherwise admissible evidence. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 30: All documents and things related to Applicant's awareness of any of Opposer Blue Cross and Blue Shield Association's Blue Marks or FITBLUE Marks.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In particular, Applicant does not know what the term "Blue Marks" means or was intended to include, and Opposer's definition of "Blue

Marks” does not include a list of said marks. In addition, Applicant objects to this request because it disputes that Opposer has any FITBLUE Marks. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 31: All documents and things concerning any consideration of or analysis by Applicant regarding any Blue Cross and Blue Shield Association’s Blue Marks or FITBLUE Marks.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In particular, Applicant does not know what the term “Blue Marks” means or was intended to include, and Opposer’s definition of “Blue Marks” does not include a list of said marks. In addition, Applicant objects to this request because it disputes that Opposer has any FITBLUE Marks. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 32: All documents and things evidencing or relating to the geographic areas where Applicant offers or sells Applicant’s Services under Applicant’s Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, see response to requests 12 and 13.

Request 33: All documents and things evidencing or relating to the channels of trade in which Applicant offers or sells Applicant’s Services under Applicant’s Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, see

response to requests 12 and 13.

Request 34: All documents and things evidencing or relating to the class of customers for Applicant's Services offered under Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, see response to requests 12 and 13.

Request 35: All documents and things evidencing or relating to the identity of Applicant's potential customers who receive or see Applicant's advertising or other promotion using Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it seeks confidential information and trade secrets. Subject to and without waiving this objection, see response to requests 12 and 13.

Request 36: All documents and things evidencing, relating to, or analyzing any visitors of any websites that display Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 37: All documents and things constituting or relating to any and all instances of actual confusion between Applicant's Mark and Opposer Blue Cross and Blue Shield Association's FITBLUE Marks.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because

it disputes that Opposer has any FITBLUE Marks. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 38: All documents and things constituting or relating to any and all instances of actual confusion between Applicant's Mark and Opposer Blue Cross and Blue Shield Association's Blue Marks.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In particular, Applicant does not know what the term "Blue Marks" means or was intended to include, and Opposer's definition of "Blue Marks" does not include a list of said marks. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 39: All documents and things evidencing or relating to Applicant's responses to Interrogatories (Set One), including but without limitation all documents and things reviewed or relied upon by Applicant in preparing its responses.

Response: All such materials have been produced.

Request 40: All documents and things evidencing or relating to Applicant's responses to Request for Admission (Set One), including but without limitation all documents and things reviewed or relied upon by Applicant in preparing its responses.

Response: All such materials have been produced.

Request 41: All documents and things relating to the meaning or connotation of Applicant's Mark, particularly the "BLUE" portion of Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant does not have any materials other than what has already been produced.

Request 42: All documents and things relating to any communications with or marketing pitches to the following: Blue Cross Blue Shield of Arizona, Blue Cross Blue Shield of Florida or Florida Blue, Blue Cross Blue Shield of North Carolina, and Blue Cross Blue Shield of South Carolina relating to Applicant's Mark, including the goods and services offered in connection with Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. In addition, Applicant objects to this request because it seeks information which is irrelevant, immaterial and not reasonably calculated to lead to otherwise admissible evidence.

Request 43: Documents showing the identity of all other customers of Applicant for services offered in connection with Applicant's mark other than HealthNow.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Applicant does not have any materials responsive to this request.

Request 44: Documents relating to the relationship between Applicant Palladian Health, LLC and Prism Health Networks.

Response: Applicant objects to this request because it is vague, ambiguous, overbroad and unduly burdensome. Subject to and without waiving this objection, Prism Health Networks changed its name to Palladian Health, LLC.

Request 45: Copies of all marketing pitch packages to any entities relating to Applicant's Mark, including the goods and services offered in connection with Applicant's Mark.

Response: Applicant objects to this request because it is vague, ambiguous,

overbroad and unduly burdensome. In addition, Applicant objects to this request because it seeks information which is irrelevant, immaterial and not reasonably calculated to lead to otherwise admissible evidence. Subject to and without waiving this objection, see responses to requests 12 and 13.

DATED: April 18, 2013

COLUCCI & GALLAHER, P.C.



Marybeth Priore
2000 Liberty Building
Buffalo, New York 14202
Phone: (716) 853-4080
Attorneys for Applicant
Palladian Health, LLC

CERTIFICATE OF SERVICE

I, Marybeth Priore, hereby certify that a true and complete copy of the foregoing paper on the parties listed below, by mailing said copies on April 18, 2013, via U.S. First Class Mail, postage pre-paid to:

Susan G. O'Neill, Esq.
Garner K. Weng, Esq.
Christopher S. Walters, Esq.
Hanson Bridgett, LLP
425 Market Street, 26th Floor
San Francisco, California 94105



Marybeth Priore

EXHIBIT E

MATTHEW A. STRATTON
ASSOCIATE
DIRECT DIAL (415) 995-5030
DIRECT FAX (415) 995-3494
E-MAIL MStratton@hansonbridgett.com



July 1, 2013

VIA E-MAIL & OVERNIGHT DELIVERY

Marybeth Priore
Colucci & Gallaher PC
424 Main St 2000 Liberty Bldg.
Buffalo, NY 14202
Email: mpriore@colucci-gallaher.com

Re: *Blue Cross Blue and Shield Association v. Palladian Health, LLC*,
Opposition No. 91206208 (TTAB)

Dear Ms. Priore:

We have reviewed Palladian Health, LLC's ("Palladian") responses to Blue Cross Blue Shield Association's ("BCBSA") Interrogatories (Set One), Requests for Production (Set One), and Requests for Admission (Set One), and Palladian's document production. This letter seeks your cooperation with addressing deficiencies in Palladian's responses and production. See TBMP § 408.1; *See also Panda Travel Inc., v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary.") BCBSA's concerns are detailed below.

Palladian's Responses to BCBSA's Interrogatories (Set One)

As explained more fully below, many of Palladian's responses to BCBSA's interrogatories do not provide the detail required under the applicable rules. Palladian has an obligation to answer each interrogatory "separately and fully." Fed. R. Civ. P. 33(b)(3) ("Each interrogatory must, to the extent it is not objected to, be answered separately and fully in writing under oath."); TBMP § 405.04(b).

Concerning Interrogatory No. 11, please confirm that Mark Zygaj is the only person responsible for selecting Applicant's Mark for use with Applicant's Services. Palladian's response suggests that multiple people participated in the process but only Mr. Zygaj's name is provided. If others were involved, please supplement Palladian's response and provide those persons' full contact information, as requested.

In Interrogatory No. 12, BCBSA requests that Palladian provide all factual and legal bases for Palladian's contention that no likelihood of confusion exists between "Applicant's Mark vis a vis Opposer Blue Cross and Blue Shield Associations' FITBLUE Marks." In response, Palladian merely refers BCBSA to Palladian's Answer and Affirmative Defenses. This sparse response is inadequate, given the importance and relevance of the inquiry. See TBMP § 414; *see also Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313, 314 (TTAB 1973) (question of whether party believes marks to be confusingly similar is relevant). Palladian's Answer consists almost

entirely of denials while its Affirmative Defenses are a collection of unsubstantiated statements, many of which are unrelated to the issue of likelihood of confusion. Palladian has an obligation to answer each interrogatory "fully." TBMP § 405.04(b); Fed. R. Civ. P. 33(b)(3). Given Palladian's response, BCBSA will assume that Palladian has no facts to support its contention that no likelihood of confusion exists. Please appropriately supplement Palladian's response to Interrogatory No. 12.

Interrogatory No. 21 seeks all legal and factual bases for Palladian's Affirmative Defense No. 9 asserting that the parties' "services are not marketed through the same channels of trade." In response, Palladian states that Applicant's services are only marketed in New York state. Channels of trade encompass more than just the geographic area in which the services are offered for sale. See, e.g., *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1370 (Fed. Cir. 2012) (noting that channels of trade include the types of outlets through which goods are sold). Please supplement Palladian's response to Interrogatory No. 21 to include the channels of trade through which Palladian's services are sold, and not just the geographic scope of their sale.

Similarly, Interrogatory No. 22 seeks a detailed description of the channels of trade utilized by Palladian. Palladian objects by alleging that the interrogatory is "premature and asks for a legal conclusion." The objections are unwarranted. The channels of trade associated with a mark represent a factual question integral to the likelihood of confusion analysis. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) ("In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered: [...] (3) The similarity or dissimilarity of established, likely-to-continue trade channels."). Because the information sought is factual in nature, the interrogatory does not call for a legal conclusion. Further, the interrogatory is not premature. This discovery period is the appropriate time to inquire into relevant facts such as this. Please supplement Palladian's response to Interrogatory No. 22 by fully responding to the question posed.¹

Interrogatory Nos. 19-20, 24-25, 27, and 29 each seek the factual and legal bases underlying certain of Palladian's affirmative defenses enumerated in its Answer. In response to each such interrogatory, Palladian refuses to provide any additional factual or legal detail. Instead, it asserts that each of the statements "speaks for itself." This is not enough. Palladian's Affirmative Defenses are broad factual statements that imply supporting facts. For example, if Palladian states that "'FIT' is registered in trademarks for health related goods and services not owned by Opposer" and "'FIT' is used in commerce by third parties as part of trademarks for health related goods and services" (see responses to Interrogatories 19-20), what corresponding marks exist of which Palladian is aware? If "Applicant was the first to use the mark in commerce" (see response to Interrogatory 27), what underlying factual details exist to support Palladian's allegation? These statements, and the others referenced above, do not

¹ BCBSA acknowledges that its reference in Interrogatory No. 22 to Palladian's Affirmative Defense No. 2 was inadvertent and that it instead intended to refer to Affirmative Defense No. 9, and incorporate the meaning Palladian assigned to "channels of trade." If Palladian's current response to this interrogatory stems from its confusion about the Affirmative Defense referenced, this explanation should resolve it. We trust Palladian will now answer the interrogatory completely.

simply "speak for themselves." Given Palladian's responses, BCBSA will assume that Palladian has no facts to support its Affirmative Defenses. Please supplement Palladian's responses to Interrogatory Nos. 19-20, 24-25, 27, and 29 by providing the requested factual and legal bases for each statement concerned.

Interrogatory Nos. 31-34 seek the factual and legal bases for certain other of Palladian's Affirmative Defenses: detrimental reliance, unclean hands, untimeliness, and defects in BCBSA's pleadings and service. In response to each, Palladian objects that the requests are "vague, ambiguous, overbroad and unduly burdensome," but does not explain why. Palladian must object with specificity and not merely assert boilerplate. TBMP § 405.04(b); Fed. R. Civ. P. 33(b)(4). The requests are clear and precise. If Palladian maintains that any of its objections continue to apply, please provide supporting detail. Palladian further objects by stating that the interrogatories are "premature" and call "for a legal conclusion." These requests are not premature. Discovery is the appropriate time to investigate the facts underlying parties' statements in their pleadings. Further, the requests on their face seek factual and legal bases, and not conclusions. If Palladian continues to assert these affirmative defenses, please supplement its responses to Interrogatory Nos. 31-34 by detailing the factual and legal bases for why such defenses apply. Otherwise, BCBSA will assume that Palladian has no facts to support these Affirmative Defenses.

Interrogatory No. 35 asks whether Palladian conducted any trademark search before proceeding with Applicant's Mark. Palladian refuses to respond substantively and instead objects on the basis of attorney-client privilege and work product doctrine, among other objections. Whether Palladian conducted a search report and, if so, the contents of such report, are discoverable. TBMP § 414(6) ("Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived.>"). Please substantively respond to Interrogatory No. 35, and produce any search reports and related materials consulted.

Interrogatory No. 37 asks for the date on which Palladian first became aware of any of BCBSA's Blue Marks. Palladian objects in part on the grounds that it has not been given a list specifying the "Blue Marks." BCBSA's definition of the Blue Marks is sufficient to allow Palladian to respond. Nonetheless, for the purposes of this interrogatory, please see document Bates Nos. BCBSA000708-000732, which is a partial list of BCBSA's Blue Marks in the U.S. With that clarification, please supplement Palladian's response to Interrogatory No. 37 with the requested date(s).

Palladian objects to Interrogatory No. 42 ("Identify all entities Applicant pitched to perform services under Applicant's Mark") by alleging it is "vague, ambiguous, overbroad and unduly burdensome," and refuses to respond substantively. To the extent Palladian contends the interrogatory is vague and ambiguous, here is a more detailed explanation: BCBSA seeks the names of entities (e.g., businesses or organizations) to which Palladian offered or sought to offer to perform any service (e.g., administration of health benefit plans concerning fitness center memberships, promoting enrollment in fitness centers to health benefit plan members, etc.). If Palladian contends the interrogatory is overbroad and unduly burdensome, please specify why, especially given Palladian's willingness to answer similar questions in Interrogatory Nos. 43-46. Otherwise, please substantively respond to Interrogatory No. 42.

Palladian's responses to Interrogatory Nos. 44-46 state that it pitched its services to Blue Cross and Blue Shield of Florida, Blue Cross and Blue Shield of North Carolina, and Blue Cross and Blue Shield of South Carolina, but does not provide the requested names of the people to which it presented. Nor does Palladian identify the materials provided to those entities in connection with its marketing efforts. Please supplement Palladian's responses to Interrogatory Nos. 44-46 by identifying the requested individuals' names and pitch materials shared.

Interrogatory No. 47 asks Palladian to "Describe in detail the meaning of Applicant's Mark, particularly the 'BLUE' portion of Applicant's Mark." Palladian responds by stating that FITBLUE is "related to its services being provided under the mark" and lists the services identified in its trademark application. Palladian does not offer any explanation for why the BLUE portion of the mark is in any way related to the "Administration of health benefit plans concerning fitness center memberships" or "promoting enrollment in fitness centers to health benefit plan members." This information is clearly relevant and, indeed, is referenced in Palladian's document production at PALLADIAN000131-133. See TBMP § 414(4) ("Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant.)"). Please supplement Palladian's response to Interrogatory No. 47 by providing the requested detailed description.

Palladian's Responses to BCBSA's Requests for Production (Set One)

Request for Production No. 1 seeks documents related to "agreements between Applicant and HealthNow New York, Inc. addressing, covering, involving, or in any way relating to FITBLUE, Applicant's Services under Applicant's Mark, or the website at www.fitblue.com." Palladian produced some of the requested agreements, but no emails and very little correspondence. The definition of "documents" includes email. See Fed. R. Civ. P., Rule 34. If any emails or other correspondence responsive to Request No. 1 exist, please produce them.

Request for Production No. 2 concerns "communications between Applicant and HealthNow New York, Inc. addressing, covering, involving, or in any way relating to services described in the Application or Applicant's Specimen of Use." Palladian objects to the request with boilerplate, contending that the request is "vague, ambiguous, overbroad and unduly burdensome," and that the documents sought are irrelevant. The request is not vague or ambiguous, nor has Palladian explained why the request is overbroad or unduly burdensome. To the extent Palladian relies on its objection that the requested documents are irrelevant, it misconstrues the scope of discovery permitted under the FRCP and TTAB rules. BCBSA is entitled to seek discovery of any matter that is relevant to any party's claims or defenses. Fed. R. Civ. P., Rule 26(b)(1). BCBSA in part alleges that its rights in its BLUE Marks arise through use by its licensees. HealthNow New York, Inc. is a BCBSA licensee. Palladian's relationship with HealthNow is therefore relevant because rights in the FITBLUE mark may flow to BCBSA by virtue of HealthNow's use of the mark. Separately, Palladian references its response to Request for Production No. 2 as its response to Request for Production Nos. 3-4, and thereby relies on the same unsubstantiated objections. Please produce all documents responsive to Request Nos. 2-4.

Request for Production Nos. 7-9 seeks various categories of documents associated with statements contained in Palladian's Answer. Palladian objects by asserting that the requests are "vague, ambiguous, overbroad and unduly burdensome." Yet, Palladian fails to explain how

any of its objections apply. As noted above, BCBSA is entitled to seek discovery of any matter that is relevant to any party's claims or defenses. Fed. R. Civ. P., Rule 26(b)(1). Please produce all documents responsive to Request Nos. 7-9.

Request for Production Nos. 11 and 17 seeks documents associated with Palladian's federal trademark application to register FITBLUE. In response, Palladian refers BCBSA to the USPTO's online files associated with the mark. Please confirm that no non-privileged, responsive documents exist outside of the USPTO docket. If any such documents exist, please produce them. Note also that Palladian produced no emails or correspondence related to these requests. Per FRCP 34, please produce all such responsive emails and correspondence.

Request for Production Nos. 12-13 seeks documents "Applicant's creation and first use of its mark" and "Applicant's services and goods," as referenced in Palladian's Initial Disclosures. Palladian produced some of the requested documents, but virtually no emails or correspondence. Per FRCP 34, please produce all emails and other correspondence responsive to Request Nos. 12-13.

Request for Production No. 14 seeks documents "reflecting Opposer's services and goods" that Palladian referenced in its Initial Disclosures. In response, Palladian objects by alleging the request is "overbroad and unduly burdensome," and that the materials sought "are in the possession of the Opposer." These objections are inconsistent with Palladian's prior statements. Palladian notes in its Initial Disclosures that such documents "are in the possession, custody, or control of Applicant and may be used to support its claims and defenses." BCBSA is entitled to seek discovery of any matter that is relevant to any party's claims or defenses. Fed. R. Civ. P., Rule 26(b)(1). Palladian previously asserted that it possessed relevant documents and must now produce them. Please produce all documents responsive to Request No. 14.

Similarly, Request for Production No. 15 calls for "All 'Documents reflecting third party use and registration of marks containing the word [] BLUE,' as referenced in Applicant's Initial Disclosures in this proceeding." Palladian responds to the request with various boilerplate objections and does not agree to produce any responsive documents. The objections don't apply. Palladian's own Initial Disclosures state that such documents "are in the possession, custody, or control of Applicant and may be used to support its claims and defenses." As noted above, BCBSA is entitled to seek discovery of any matter that is relevant to any party's claims or defenses. Fed. R. Civ. P., Rule 26(b)(1). By asserting that it has such documents and may rely on them in this proceeding, Palladian waived any basis to otherwise withhold them. Please produce all documents responsive to Request No. 15.

In response to Request for Production No. 16 (documents related to the "creation, consideration, design, development, selection, or adoption of Applicant's Mark"), Palladian refers BCBSA to its response to Request for Production No. 12 (documents "reflecting Applicant's creation and first use of its mark"). This is insufficient. See *Mulero-Abreu v. P.R. Police Dep't*, 675 F.3d 88, 93 (1st Cir. 2012) ("answering interrogatories simply by directing the proponent to rummage through other discovery materials falls short of the obligations imposed by Rule 33."). Further, because Request No. 16 is broader than Request No. 12, please confirm that all documents responsive to Request No. 16 have been produced. If not, please

produce them. Note also that Palladian produced virtually no emails or correspondence. Per FRCP 34, please produce all responsive emails and other correspondence.

Request for Production No. 18 concerns "any searches or other due diligence regarding Applicant's Mark, including but without limitation all documents and things relating to the availability of Applicant's Mark for use or registration." Palladian declines to produce any documents on the basis of attorney-client privilege and the attorney work product doctrine. As noted above, the contents of any search reports consulted are discoverable. TBMP § 414(6). Please produce any search reports consulted and all other non-privileged due diligence documents (including emails/correspondence) responsive to this request.

In response to Request for Production Nos. 21-24, 26, 28, 32-35, and 45, Palladian refers BCBSA to its responses to Request for Production Nos. 12-13. As noted above, this is insufficient. See *Mulero-Abreu v. P.R. Police Dep't*, 675 F.3d at 93 (1st Cir 2012). Further, given that the categories of documents sought in Request Nos. 21-24, 26, 28, 32-35, and 45 are collectively broader than those sought in Request Nos. 12-13, please confirm that all responsive documents have been produced. If not, please supplement Palladian's production accordingly. For example, documents in the following categories appear to have been minimally produced, or not produced at all: Palladian's first dates of use of FITBLUE (Request No. 23), correspondence with advertising and sales agents (24), marketing plans (26), comprehensive printouts from www.fitblue.com (27), the identities of newsletter recipients (28), channels of trade for services under FITBLUE (33), potential customers (35), and marketing pitch packages (45). Note also that Palladian produced virtually no emails or correspondence. Per FRCP 34, please produce all emails and other correspondence responsive to these requests.

Request for Production No. 42 seeks documents related to communications and marketing pitches made to selected BCBSA licensees. Palladian objects in part by alleging that the requested documents are irrelevant. The scope of distribution of a party's services and efforts to expand its use of a mark are discoverable. See TBMP §§ 414(8), (16); see also *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (information regarding geographic areas of distribution of goods is relevant to questions of likelihood of confusion and abandonment); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988). Documents concerning Palladian's efforts to market its services to healthcare organizations in different geographic markets are relevant in this proceeding. Please produce all documents responsive to Request No. 42.

Palladian's Responses to BCBSA's Requests for Admission (Set One)

Request for Admission Nos. 14-17 concern Palladian's knowledge and notice of BCBSA's "Blue Marks." Palladian refuses to respond substantively on the basis that it has not been provided a specific list of such "Blue Marks." BCBSA's definition of the Blue Marks is sufficient to allow Palladian to admit or deny the request. Nonetheless, for the purposes of this request, please see document Bates Nos. BCBSA000708-000732, which is a partial list of BCBSA's Blue Marks in the U.S. Please promptly supplement Palladian's responses to Request Nos. 14-17.

Request for Admission No. 37 states that "Applicant did not consult with, obtain permission from, or inform HealthNow or Opposer prior to filing the Application Serial No. 85/363,867." In response, Palladian objects by claiming it "does not know what the terms 'consult with, obtain

permission from, or inform' means or was intended to include." BCBSA employs the common usage of these terms. They are not "vague and ambiguous," as alleged. BCBSA is asking Palladian to admit that it did not consult with (e.g., discuss with), obtain permission from (e.g., get consent from), or inform (e.g., notify) HealthNow or BCBSA before Palladian filed trademark Application Serial No. 85/363,867. Ultimately, Palladian admits that "Applicant came up with the mark FITBLUE, and advised HealthNow of its use of said mark." This response does not correlate to the original statement. BCBSA's request concerns Palladian's communications with HealthNow or BCBSA before Palladian's filing of the subject trademark application. By contrast, Palladian's response addresses communications after Palladian's use of FITBLUE. Please supplement Palladian's response to Request No. 37 by admitting or denying the subject statement.

Privilege Log

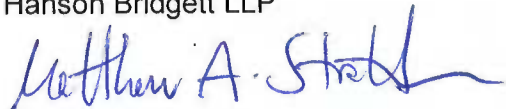
Just as you have requested a privilege log from BCBSA, we ask for the same from Palladian. We suggest discussing the scope of privilege logs generated in this matter before proceeding. For example, eliminating the need to record privileged communications between the parties and counsel after the filing of the Notice of Opposition would reduce the burden to the parties.

BCBSA reserves the right in the future to address further deficiencies it identifies with Palladian's discovery responses and document production.

Please promptly supplement Palladian's responses and document production. Thank you in advance for your cooperation. If you have any questions, please contact me as soon as possible.

Very truly yours,

Hanson Bridgett LLP



Matthew A. Stratton

EXHIBIT F

Christopher S. Walters

From: Christopher S. Walters
Sent: Friday, June 20, 2014 3:44 PM
To: 'mpriore@colucci-gallagher.com'
Cc: Garner K. Weng
Subject: BCBSA v. Palladian -- Discovery

Dear Marybeth,

We have not received any response from you to our July 1, 2013 letter requesting your assistance remedying various deficiencies in Palladian's discovery responses, which we consider to have been a reasonable attempt to meet and confer. With the case schedule being what it is, we will be bringing a motion to compel responses. Please advise if you wish to discuss the matter.

Best regards,

Christopher S. Walters

Attorney

Hanson Bridgett LLP

(415) 995-5017 Direct

(415) 995-3589 Fax

cwalters@hansonbridgett.com



HansonBridgett

425 Market Street, 26th Floor

San Francisco, CA 94105

San Francisco | Sacramento | North Bay | East Bay



This communication, including any attachments, is confidential and may be protected by privilege. If you are not the intended recipient, any use, dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify the sender by telephone or email, and permanently delete all copies, electronic or other, you may have.

The foregoing applies even if this notice is embedded in a message that is forwarded or attached.

EXHIBIT G

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

vs.

PALLADIAN HEALTH, LLC,

Applicant.

*
*
*
* OPPOSITION No. 91206208
*
* MARK: FITBLUE
*
* APPLICATION No. 85363867
*
*
*

APPLICANT'S RULE 26(A)(1) INITIAL DISCLOSURES

Applicant, Palladian Health, LLC, by its attorneys, hereby submits its Rule 26(a)(1) Initial Disclosures:

FRCP 26(a)(1)(A)(i):

The following individuals may have discoverable information that Applicant may use to support its claims and defenses unless solely for impeachment:

- a.) Applicant and its principals, members and employees (contact through counsel). Subjects: use and ownership of the Applicant's mark; design, inspiration and creation of Applicant's mark; Applicant's business operations and activities; Applicant's goods and services; Applicant's trademark application; and facts and defenses alleged in the Notice of Opposition and Answer thereto.
- b.) Representatives from Opposer and its affiliates, licensees and related entities, including but not limited to, Blue Cross and Blue Shield Association of Western New York. Subjects: use and ownership of Opposer's marks; Opposer's business operations and activities; Opposer's products and services; Opposer's trademark applications and registrations; and Opposer's assertions of fact alleged in the Notice of Opposition.
- c.) Any individuals disclosed by Opposer in its Rule 26 initial disclosures.

- d.) Any individuals named in depositions.
- e.) Any individuals named in pleadings and discovery.

FRCP 26(a)(1)(A)(ii):

The following documents, electronically stored information and tangible things are in the possession, custody, or control of Applicant and may be used to support its claims and defenses:

- a.) Documents associated with Applicant's federal trademark application.
- b.) Documents reflecting Applicant's creation and first use of its mark.
- c.) Documents reflecting Applicant's services and goods.
- d.) Documents reflecting Opposer's services and goods.
- e.) Documents reflecting third party use and registration of marks containing the works BLUE.

Applicant reserves the right to amend this Initial Disclosure upon identification of other documents and things through discovery or through development of the issues.

DATED: November 7, 2012

COLUCCI & GALLAHER, P.C.



Marybeth Priore
2000 Liberty Building
Buffalo, New York 14202
Phone: (716) 853-4080
Attorneys for Applicant
Palladian Health, LLC

CERTIFICATE OF SERVICE

I, Marybeth Priore, hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition was served on the parties listed below, by mailing said copies on November 7, 2012, via U.S. First Class Mail, postage pre-paid to:

Susan G. O'Neill, Esq.
Garner K. Weng, Esq.
Christopher S. Walters, Esq.
Hanson Bridgett, LLP
425 Market Street, 26th Floor
San Francisco, California 94105

A handwritten signature in cursive script, appearing to read "M. Priore", written over a horizontal line.

Marybeth Priore